

No. 11652.

IN THE

United States Circuit Court of Appeals
FOR THE NINTH CIRCUIT

LEROY J. LEISHMAN,

Appellant,

vs.

RADIO CONDENSER COMPANY and GENERAL INSTRUMENT
CORPORATION,

Appellees.

RADIO CONDENSER COMPANY and GENERAL INSTRUMENT
CORPORATION,

Cross-Appellants,

vs.

LEROY J. LEISHMAN,

Cross-Appellee.

APPELLANT'S OPENING BRIEF.

LEROY J. LEISHMAN,
2921 Greenfield Avenue, Los Angeles 34,
Appellant, in propria persona.

NOV 19 1947

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vs.

LeROY J. LEISHMAN,

Cross-Appellee.

APPELLANT'S OPENING BRIEF.

Statement of Pleadings and Facts Upon Which
Jurisdiction Is Based.

This is an appeal by defendant from a Summary Judgment entered on September 12, 1946, and amended December 18, 1946, holding that claims 7 to 11, inclusive, of Reissue Letters Patent No. Re. 20,827 are not infringed by the manufacture, use, or sale of condensers and tuners, as exemplified by Radio Condenser Company Model 28 tuner and General Instrument Corporation Model 31 tuner [R. Vol. I, pp. 94, 133, 134].

The jurisdiction of the District Court was based upon:

(a) U. S. Code, Patents, Title 35, Section 67;

(b) The Declaratory Judgment Act, Section 274-D of the Judicial Code, 28 U. S. Section 400; and

(c) Diversity of citizenship. The plaintiffs both have their principal places of business in the State of New Jersey. The defendant resides in the City of Los Angeles, California.

The complaint [R. Vol. I, p. 2] alleged that claims 7 to 11 of Reissue Patent No. 20,827 were invalid and not infringed.

Defendant's Answer [R. Vol. I, p. 15] denied that the said claims were invalid and not infringed, and Defendant's Counter Claim charged infringement of the said claims and asked for the usual accounting.

Five days after entry of the original judgment, the time for filing a Motion under Rule 52b of the Federal Rules of Civil Procedure was extended until October 16, 1946 [R Vol. I, p. 97].

The aforementioned Motion under Rule 52b [R. Vol. I, p. 100] was filed on October 16, 1946.

The said motion was granted in part and the judgment amended on December 18, 1946 [R. Vol. I, pp. 133 and 134].

Notice of appeal from the final amended judgment was filed on March 17, 1947 [R. Vol. I, p. 136].

The jurisdiction of the Circuit Court of Appeals is based upon Judicial Code, Title 28 U. S. C., Section 225.

Statement of the Case.

The complaint [R. Vol. I, p. 2] was filed under the Declaratory Judgment Act and alleges that claims 7 to 11 of appellant's Patent No. Re. 20,827 are invalid and not infringed by the devices manufactured by appellees. The complaint states [R. Vol. I, p. 3] that an actual controversy exists, and in the fourth and fifth paragraphs [R. Vol. I, pp. 4, 5 and 6] it identifies the said controversy as a suit filed by appellant (and subsequently won by him) against The Richards and Conover Company in the Western District of Oklahoma, Civil Action No. 2155, charging infringement of the said patent by the Oklahoma defendant through the sale of Motorola radio receivers manufactured by the Galvin Manufacturing Company of Chicago and containing instruments made by each of the appellees. The Declaratory Judgment complaint prayed for a judgment of invalidity and non-infringement and requested [R. Vol. I, pp. 10 and 11] preliminary and final injunctions enjoining appellant from any act alleging infringement of any claim of the said patent by appellees or any of their customers.

The complaint pointed out [R. Vol. I, p. 7] that this Honorable Court, in the case of *LeRoy J. Leishman v. Associated Wholesale Electric Company*, 137 F. (2d) 722, held that the patent here in suit was not infringed by the (Crosley) tuner there involved.

Appellant's Answer [R. Vol. I, p. 15] denied that the patent was invalid and that it was not infringed by the appellees' tuners, and a counter claim was filed [R. Vol. I, p. 16] alleging infringement of claims 7 to 11 of the said patent through appellees' manufacture and sale of the said tuners.

On January 23, 1946, appellees filed a motion for summary judgment [R. Vol. I, pp. 27 and 28], accompanied by an affidavit of Samuel S. Mackeown [R. Vol. I, p. 29 *et seq.*] to the effect that appellees' tuners were in all material respects the same as the Crosley tuner involved

in the *Associated* case, *supra*. Memoranda and oral arguments of the appellees urged a decision in their favor on the basis of *stare decisis*.

Appellant opposed appellees' Motion for Summary Judgment. Ten prior art patents and sixteen other exhibits were filed in his behalf, together with an affidavit of LeRoy J. Leishman [R. Vol. I, p. 46] setting forth that none of these exhibits were in the record of the *Associated* case, *supra*.

Appellees' Motion for Summary Judgment was opposed upon the ground that the Ninth Circuit Court of Appeals did not have the benefit of this evidence when deciding the *Associated* case; that a decision based upon this evidence would be entirely different from the decision in the former action; and that when the evidence is different a former decision of an appellate court is not controlling upon the lower court, and hence a summary judgment could not be rendered upon the basis of *stare decisis*, as urged by appellees.

Although a hearing was held on appellees' Motion for Summary Judgment before the aforementioned Oklahoma action came to trial, the said trial was held and the judgment therein entered before the summary judgment was entered in the instant case. The same ten prior art patents and 16 other exhibits that are in the present record and which were not of record in the *Associated* case, were in evidence in the Oklahoma action and discussed at the trial. In deciding that case, the United States District Court for the Western District of Oklahoma held that claims 7 to 11 of the patent (the same claims at issue here) were "clearly valid and clearly infringed" by *the same tuners involved in the present action* [see Oklahoma Finding 6, R. Vol. I, p. 53].

After the Oklahoma trial, the appellant on May 25, 1946, filed a Motion to Deny Plaintiffs' Motion for Summary Judgment and Motion to Dismiss the Declaratory

Judgment Complaint [R. Vol. I, p. 47 *et seq.*], setting forth that it could not summarily be held that the tuners here at issue did not infringe claims 7 to 11 of the appellant's patent when the Oklahoma court had just held after a full trial that these same tuners were clear infringements.

On June 21, 1946, appellant filed a Motion under Rule 15d [R. Vol. I, p. 63 *et seq.*] requesting leave to file a supplemental answer [R. Vol. I, p. 72 *et seq.*] to the effect that appellees were bound by the Oklahoma decision because of their participation in the defense of the Oklahoma suit, which said participation was set forth in the Second Affidavit in Support of Motion under Rule 15(d) [R. Vol. I, p. 69 *et seq.*].

Summary Judgment of non-infringement was entered in favor of appellees [R. Vol. I, p. 94 *et seq.*] and the injunction prayed for in the complaint was entered on September 18, 1946.

In acting upon appellant's Motion under Rule 52(b) to amend the findings, conclusion and judgment [R. Vol. I, p. 100 and 101], the District Court denied appellant's aforementioned Motion under Rule 15(d) for permission to file a supplemental answer, but the judgment was amended to permit appellant to proceed against the defendant in the Oklahoma case and against the Galvin Manufacturing Company, which was bound by the Oklahoma decision [R. Vol. I, pp. 133 and 134]. This amended portion of the judgment is the subject of plaintiffs' cross appeal.

The first question presented by the present appeal has to do with the effect of the evidence in the present record that was not in the record of the *Associated Wholesale Electric* suit, *supra*. The lower court in the instant case based its decision upon this appellate court's ruling in the *Associated* case that one of the elements of the then accused tuner (which element is also present in appellees'

tuners) was not the equivalent of the corresponding element shown in the patent. The new and different evidence shows that these elements were well known equivalents in this art before the patent at issue was granted. Appellant contends that no decision can now be rendered consistent with this new evidence excepting one to the effect that appellees' devices are clear infringements, as the Oklahoma court held them to be.

Another important question may be expressed as follows: If summary judgment is rendered upon the basis of *stare decisis* when the complaint and answer raise important issues of fact, how can an opposing party, thus cut off without a trial, present evidence that may show the previous decision was in error?

The next question presented by this appeal has to do with the propriety of the District Court's refusal to permit appellant to file a supplemental answer setting forth the additional defense that appellees are bound by the decision in the Oklahoma suit because of their participation therein.

A fourth question relates to whether or not appellees are precluded from contesting the validity of the patent. Instead of intervening in the suit which appellant provided for them in Oklahoma, appellees tried to stop that suit and insisted upon bringing the contest into this circuit where they expected that the doctrine of *stare decisis* would give them a rubber-stamped decision based upon this court's opinion in the *Associated* case, *supra*. But in that opinion this court set aside the lower court's finding of invalidity, and resolved any doubts there may have been on this issue in favor of the patent by striking out that portion of the District Court's opinion which ruled the patent was invalid for want of invention. The Appellate Court's decision in the *Associated* case thus restored the presumption of validity to the patent. Appellant contends that appellees, who came to this circuit

to benefit by the *Associated* decision, and who urge that this decision be applied, are thereby precluded from attacking the validity of the patent. The matter of validity was not brought before the lower court, but it is of importance here for the reason that if appellees are precluded from raising this issue, a holding of infringement will dispose of the case.

Should this court fail to hold that appellees are bound by the Oklahoma decision, or that they are precluded from contesting the validity of the claims, it then becomes necessary for this court, in remanding the case for a trial, to decide whether it was proper for the lower court to sustain appellees' objections to appellant's interrogatories [R. Vol. I, p. 21 *et seq.*]. The answers to these interrogatories were needed to determine the extent of the commercial success of the devices involved. This court and others have repeatedly held that commercial success and public acceptance constitute important evidence in resolving the issue of invention if doubt appears. Appellees' objections were to the effect that the information called for was irrelevant to any issue in the case [R. Vol. I, p. 25], and the court sustained the objections [R. Vol. I, p. 26].

A very important question presented by this appeal is whether or not the District Court should have granted a *summary* judgment in direct conflict with a decision rendered by another U. S. District Court after a *full trial*, the U. S. District Court for the Western District of Oklahoma having just previously held that the *same* tuners here involved are clear infringements of the very claims here at issue.

Another question, which apparently needs to be answered by this court again, is whether a lower court, upon a new and different record, is required to follow a former decision of an appellate court.

Specification of Errors Relied Upon.

1. The District Court erred in holding that appellees have not infringed claims 7 to 11 of U. S. Re-issue Letters Patent No. Re. 20,827.

2. The District Court erred in making Finding 18 to the effect that "No evidence has been presented to the court by defendant which could in any manner change or affect the ruling of the Circuit Court of Appeals in the aforesaid case [*Leishman v. Associated Wholesale Electric Co.*, 137 F. (2d) 722] that plungers and levers in the alleged patented combination do not function in the same way, or in substantially the same way, and are therefore not equivalents." [R. Vol. I, p. 91.]

3. The District Court erred in making Finding 19 to the effect that "There is no genuine issue as to any material fact and no controversial question of fact to be determined at a trial respecting the issue of infringement of Claims 7 to 11, inclusive, of Reissue Letters Patent No. Re. 20,827 by plaintiffs' Radio Condenser Company Model 28 tuner or General Instrument Corporation Model 31 tuner." [R. Vol. I, p. 91.]

4. The District Court erred in following the decision of the Ninth Circuit Court of Appeals in the case of *LeRoy J. Leishman v. Associated Wholesale Electric Company*, 137 F. (2d) 722, which was based upon a record vastly different from that in the instant case.

5. The District Court erred in basing a summary judgment upon the doctrine of *stare decisis*, for the reason that it cannot be decided whether or not that doctrine is applicable until all of the evidence is in.

6. The District Court erred in granting summary judgment in direct conflict with a previous decision of another U. S. District Court, rendered after a full trial, to the effect that the claims here at issue are clearly valid and clearly infringed by the very tuners involved in the instant suit.

7. The District Court erred in sustaining appellees' objections to appellant's interrogatories 4, 5, 6, 7, 10, 11, 17 and 18, requiring data on the volume of appellees' sales to show the extent of the commercial success of appellees' devices.

8. The District Court erred in denying appellant's motion under Rule 15d, F. R. C. P., for permission to file a supplemental answer to the complaint, which said supplemental answer alleged that appellees were bound by the decision of the U. S. District Court for the Western District of Oklahoma in the case of *Leishman v. The Richards and Conover Company*, Civil Action No. 2155, for the reason that appellees herein participated in the defense of that suit.

9. The District Court erred in failing to hold that appellees were bound by the decision of the U. S. District Court for the Western District of Oklahoma in the said case of *Leishman v. The Richards and Conover Company*.

10. The District Court erred in denying any part of appellant's Motion under Rule 52(b). This motion asked for changes to correct errors in the Findings of Fact, Conclusions of Law, and Judgment; and it proposed a different set of findings and legal conclusions and a judgment in accordance therewith.

ARGUMENT.

Introduction to the Argument.

In granting summary judgment that the claims at issue are not infringed by appellees' devices, the lower court has violated the rules pertaining to summary judgments as well as those governing the doctrine of *stare decisis*.

In *Cohen et al v. Eleven West 42nd Street, Inc.*, Second Circuit, 115 F. (2d) 531, 532, the court said:

"A motion for summary judgment is not a trial; on the contrary it assumes that scrutiny of the facts will disclose that the 'issues presented by the pleadings' need not be tried because they are so patently insubstantial as not to be genuine issues at all."

One of "the issues raised by the pleadings" in the instant case, was the issue of infringement. If this issue was *so patently insubstantial as not to be a genuine issue at all*, then it would appear that the lower court would have to agree with the U. S. District Court for the Western District of Oklahoma, which held after a full trial that appellees' devices were "clear infringements" of the same claims here at issue [Oklahoma findings 6 and 26, R. Vol. I, pp. 53 and 59]. But our District Court rendered a *summary* judgment that they did *not* infringe.

In *Ramsouer v. Midland Valley R. Co.*, 135 F. (2d) 101, 106, the Eighth Circuit Court, in speaking of a motion for summary judgment, said:

"In considering such a motion as in a motion for a directed verdict, the court should take that view of the evidence most favorable to the party against whom it is directed, giving to that party the benefit of all favorable inferences that may reasonably be drawn from the evidence. If, when so viewed, reasonable men might reach different conclusions, the motion should be denied and the case tried on its merits."

It is obvious that no such rule was followed in the present case.

Instead, the lower court rendered a summary judgment based upon a misapplication of the doctrine of *stare decisis*. This doctrine requires that a previous decision be followed in a subsequent case in so far as the evidence is the same, but it does not require that the previous decision be followed where the evidence is different. The evidence in the instant case was so vastly different from that in *Leishman v. Associated Wholesale Electric Co., supra*, that the *Associated* decision was no longer applicable, yet the lower court nevertheless followed that former ruling.

It is axiomatic that a court cannot tell what the evidence in a new case is going to be until the evidence is all in. It follows, then, that *stare decisis* can never be applied in the absence of a trial unless the litigants admit in advance that the evidence would be the same as in the former case. In the instant case, however, the lower court based its *summary* judgment upon the doctrine of *stare decisis*, notwithstanding appellant's insistence on a full trial in order to bring out all the pertinent evidence.

Despite the Oklahoma decision that appellees' devices infringe the claims here at issue, despite a record vastly different from that in the *Associated* case, and despite all the precautions urged by the courts regarding summary judgments and the application of the doctrine of *stare decisis*, the lower court nevertheless cut appellant off without a trial and gave appellees a rubber stamped decision based upon this court's opinion in the *Associated* case.

In order that this Honorable Court may be fully apprised of the gross impropriety in granting the motion for a summary judgment, we shall now more fully discuss the matter of the former decision and what effect, if any, it has in *this* suit.

The Issue of Infringement as Affected by the Former Decision and the New Evidence.

a. THE FORMER DECISION AND APPELLEES' ADMISSIONS SIMPLIFY THE ISSUE.

Appellant and appellees agree that appellees' tuners are the same in all essential respects as the Crosley tuner involved in the case of *Leishman v. Associated Wholesale Electric Co.*, 137 F. (2d) 722. The affidavit of Samuel S. Mackeown, submitted by appellees in support of their Motion for Summary Judgment, says:

“Insofar as the subject matter of Reissue Letters Patent No. Re. 20,827 is concerned, these three tuning units (Exhibits 1 and 2, Exhibits 3 and 4, and the Crosley tuner Exhibit A) are identical.” [R. Vol. I, p. 31.]

Two of the three elements in the Crosley tuner were held by this Honorable Court to be the equivalents of the corresponding elements in the reissue patent here in suit.

The third element in the Crosley tuner was held not to be the equivalent of the corresponding element shown in the patent. But when that decision was rendered, this court did not have the benefit of any evidence to show that these elements were already well known in the art as proper substitutes or mechanical equivalents at the time of the grant of the patent. This evidence is now supplied in the present record, and all three elements can therefore be shown to be the equivalents of the corresponding parts of the patented structure.

Before we can discuss these parts, it will first be necessary to become familiar with the device set forth in the patent.

b. DESCRIPTION OF THE PATENTED DEVICE.

The court is doubtless familiar with radio receivers in which the stations may be tuned in by pressing keys or buttons. This type of tuning is called *automatic* tuning. Many automatic tuners merely operate or actuate the regular tuning shaft that would otherwise be turned by the manual tuning knob, and they are therefore sometimes referred to as *actuators*. The patent at issue [R. Vol. II, p. 169] pertains to this kind of a device.

Inasmuch as this type of tuner or actuator merely turns the regular tuning member to the proper angular position required to bring in a given station, it follows that such an actuator could also be used to turn the control shaft or knob of other mechanisms. Accordingly, the patent says that one of the purposes of the invention is "to provide simple apparatus for turning dials, shafts and the like to the particular settings required in using an instrument or machine for a definite task; . . ." [R. Vol. II, p. 169, column 1, lines 11 to 15].

The operation of some machines required the turning of more than one dial or knob. In order that his mechanism might also perform this double task, the inventor provided for the inclusion of an extra set of some of the parts. This second object of his invention was mentioned in the clause immediately following the one quoted in the previous paragraph. This second clause reads: "to afford means whereby a *plurality* of such rotatable elements may be simultaneously turned each to a pre-selected position which may be different from that to which any other such element is being turned." [R. Vol. II, p. 169, column 1, lines 15 to 19.]

When applying appellant's invention to radio receivers, it is necessary to position only *one* shaft. In the broadcasting of television programs, it is possible to broadcast the pictures and the sound on totally different, unrelated frequencies or dial readings. Such programs may be

tuned in by the arrangement having the double set of parts for turning a *plurality* of shafts. These two different adaptations of appellant's invention are mentioned in the objects as follows: "to make it possible for a single manual operation to tune *either* a radio set or a television set, or *both*." [R. Vol. II, p. 169, column 1, lines 28 to 30.]

For the court's convenience, the patent drawings have been reproduced on the opposite page.

Inasmuch as the accused tuners and the claims at issue are concerned only with *radio* tuning, we are interested only in the parts required for turning a single shaft to a predetermined angular position. Referring to Fig. 1, the specification says that shaft S "may be considered as connected to a radio tuning device" [R. Vol. II, p. 169, second column, lines 23 to 25]. In order to operate this shaft, the device illustrated in the drawings includes a member 48, shown attached to shaft S by pin 52. For easy identification, member 48 has been colored green. It may also be seen in Fig. 2. This member moves like the treadle of an old-fashioned sewing machine, and is referred to in the specification and in the claims at issue as a *rocker*. The drawings also show a second rocker 54, but this second rocker is only employed when a second shaft is to be positioned.

Inasmuch as shaft S is connected to the regular radio tuning shaft, the rocker 48 will assume different angular positions according to what station is tuned in. A given tilt of the rocker thus corresponds to a given station. The job of the other parts of the automatic tuner is therefore to correctly *position* the rocker for the different stations. The element that actually does this positioning is referred to in some of the claims as a *positioning element*. This element is member 61, colored red in Fig. 2, and shown in contact with the rocker. It is referred to in the specifications and in claims 7 and 8 as a *tappet*.

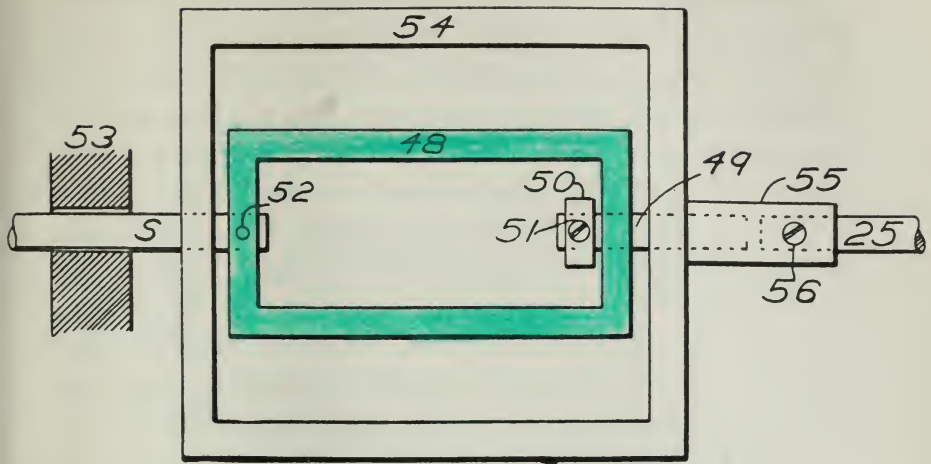


Fig. 1

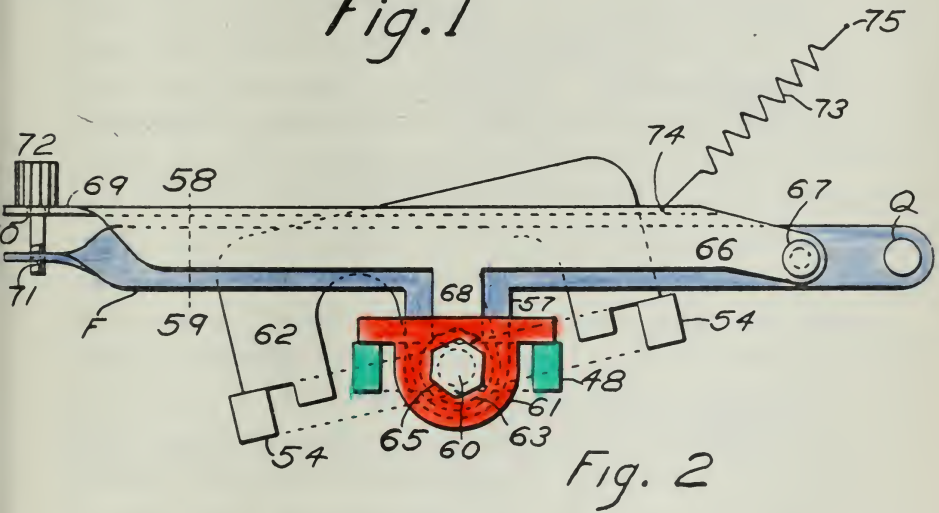


Fig. 2

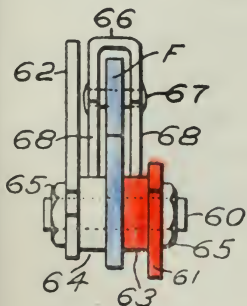


Fig. 3

INVENTOR.

Le Roy J Leishman

Some kind of an operating member must be provided to carry the positioning element, or tappet, 61 and move it in and out of engagement with the rocker. In the illustrative embodiment shown in the drawings, the positioning element is therefore pivoted by means of pin 60 to a short plunger 57 extending from a lever F. In order for the positioning element properly to position the rocker, the positioning element or tappet must be adjusted and fixed on its pivot in the same angular position that the rocker is to assume. Thumb screw 72, which is threaded into the outer end 71 of lever F, is then tightened in order to clamp projection 68 of lever 66 against the hub 63 of the tappet. (*See Fig. 3, p. 15.*)

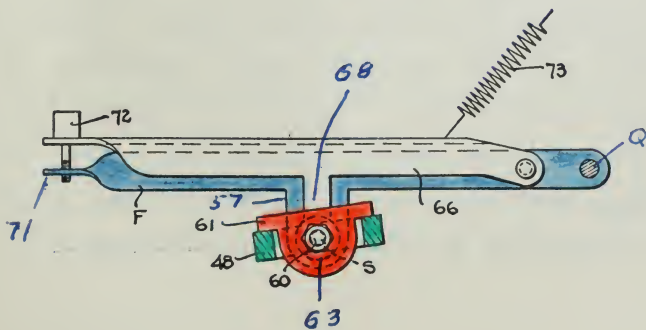
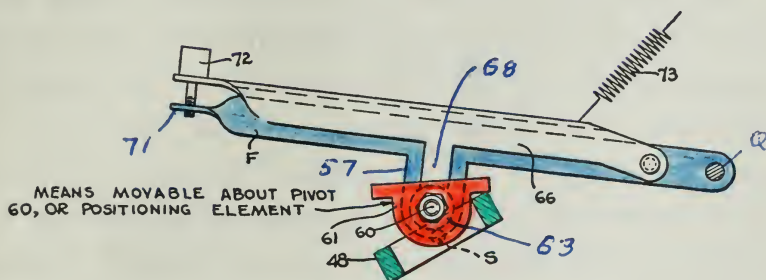
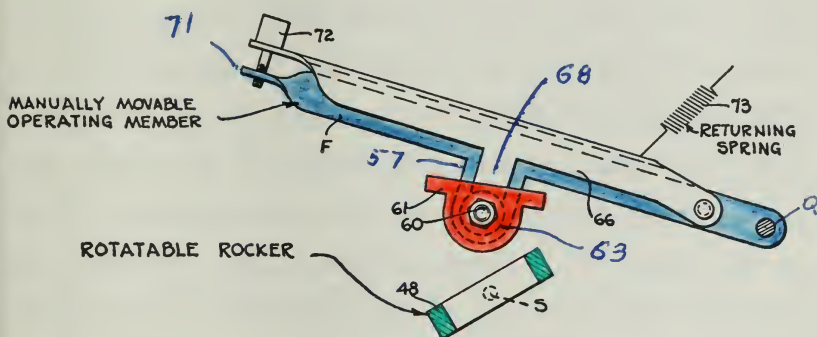
When the tappet is to be initially set for a given station, the set screw 72 must be loosened so that the tappet will be free to turn. The station is then carefully tuned in by the regular manual knob (not shown). This causes the rocker to assume an angular position which is specific to that station. If the freely pivoted tappet is then pressed into firm engagement with the rocker by means of the thumb screw or operating button 72, the tappet will assume the same tilt as the rocker. Thumb screw 72 is then tightened to lock the tappet in this adjusted position.

After the positioning element 61 has been set for the desired station, the operator may remove his finger from button 72, and spring 73 will cause the operating member to move up so that the positioning element will be out of the way of the rocker, which will then be free to turn to other angular positions as other stations are tuned in.

Whenever the button 72 is again pressed down, the positioning element will engage the rocker in whatever angular position it may be found, and the positioning element will rotate the rocker and position it to the exact tilt required to bring in the station for which the positioning element has been set. On page 17 hereof, the top figure shows the tappet completely out of engagement

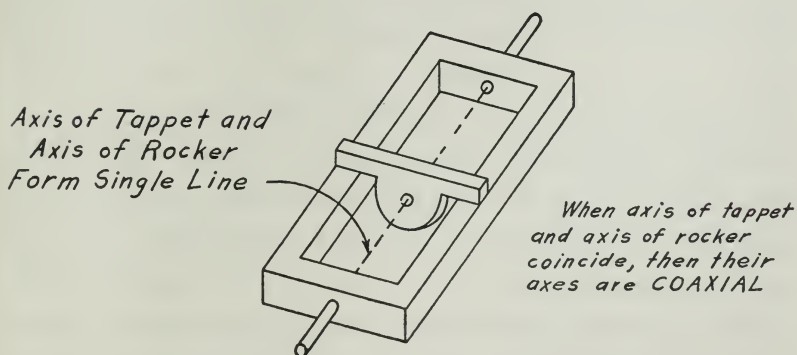
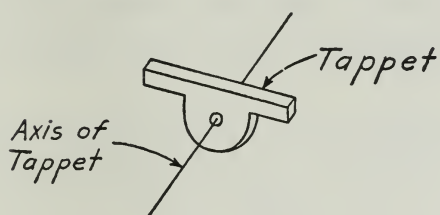
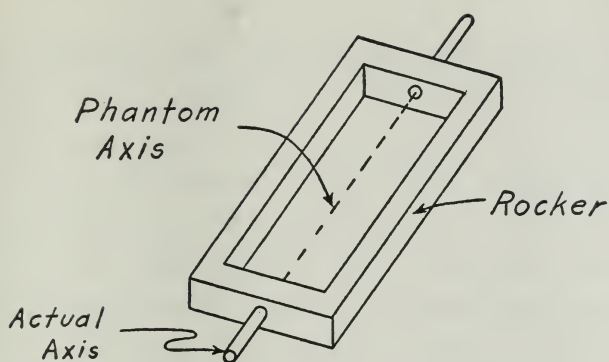
with the rocker. In the middle figure, one side of the tappet is just engaging one arm of the rocker. The lower figure shows these parts in complete engagement, and it will be observed that the tappet has positioned the rocker to the same angular position occupied by the positioning element itself.

If a plurality of operating levers are mounted on shaft Q, each of the associated tappets may be adjusted to bring in a different station.



In Fig. 2 of the patent drawings (page 15 of this brief) both arms of the positioning element are shown in engagement with both arms of the rocker. It will be seen that the axis of the tappet is then coaxial with the axis of the rocker. Specific attention is called to this fact in the specification of the patent [R. Vol. II, p. 170, column 1, lines 30 to 34] where it says: "When the lever assembly is all the way down, it will be observed from Fig. 2 that the pin 60 is substantially co-axial with the rockers 48 and 54, which means that in this position it is also co-axial with shafts S, 49 and 25, shown in Fig. 1." This substantial coaxial relationship of the rocker and tappet in the tuned-in position is very important. That is the reason it is clearly shown in the drawings and stressed right at the end of the specification in the patent.

On page 19 of this brief, the positioning element and the rocker are shown disassociated from the rest of the apparatus. In the ^{central} top figure, the axis of the tappet is indicated. The ^{tapp} central figure shows how the rocker is cut away where its axis is located. The axis of rotation is of course still there, and it might consequently be referred to as a phantom axis. In the tuned-in position shown in the lower figure, the axis of the tappet is seen to be coaxial with the axis of the rocker. When this relationship does not prevail, peculiar difficulties are encountered when trying to adjust the loosened tappet to the proper angular position required for a given station: but when these parts have the coaxial relationship called for in the patent, no difficulties are encountered.



C. PLAINTIFFS' AND DEFENDANT'S TUNERS COMPARED
WITH THE ACCUSED TUNER IN THE ASSOCIATED
CASE.

It has already been pointed out that appellees allege, and appellant agrees, that the appellees' tuners are the same in all essential respects as the Crosley tuner involved in the *Associated* case, *supra*. Mention has also been made of the fact that this Honorable Court held that two of the three elements of the Crosley tuner were equivalents of the corresponding elements of the patented structure, but that the third element was held not to be an equivalent. Let us identify these elements in the respective tuners in order to learn how much of the former decision is applicable by virtue of the doctrine of *stare decisis*.

On the ^{folding} ~~adjoining~~ insert, ^{between pp. 50 & 51,} appellant's tuner is shown at the top, with the Crosley tuner just below. Appellees' tuners are shown on either side of the Crosley structure. The figure at the left is taken from plaintiffs' Exhibit 1 [R. Vol. I, p. 12] and represents the tuner made by appellee Radio Condenser Company, and the figure at the right is taken from Plaintiffs' Exhibit 3 [R. Vol. I, p. 13], representing the tuner of appellee General Instrument Corporation. All of the rockers in these various tuners have been colored green and the tappets red. No explanation or argument is required to show that the appellees are correct in contending that their tuners are the same in all essential respects as the Crosley tuner discussed by this court in the *Associated* case. In so far as this court's prior decision may be properly adopted in this case, it applies with equal force to appellees' tuners.

The decision in the *Associated* case will be better understood if we first apply a couple of the claims at issue to the tuners made by appellees and the Crosley Corporation. The claims, of course, point out the portions of the structure shown in the patent that embody the invention of the patentee.

Claim 7 begins: "In combination with the tuning mechanism of a radio apparatus, . . ." This is the preamble of the claim and states the kind of mechanism with which the combination is intended to be used. The rockers, shown in green (see insert) in the Crosley tuner and in appellees' tuners are all connected to the tuning mechanism of a radio apparatus. Plaintiffs' Physical Exhibits 2 and 4 each combine the tuning mechanism and the automatic tuner or actuator into a single unit.

"a rotatable rocker mounted upon a shaft operatively connected with said mechanism . . ." This is the rocker shown in ~~red~~^{green} in each of the tuners. An examination of Plaintiffs' Physical Exhibits 2 and 4 show that the shaft attached to the rocker is operatively connected with the aforementioned tuning mechanism, which is a variable condenser.

". . . said rocker having two arms each extending on a different side of said shaft; . . ." In all of the tuners shown on the ~~adjoining~~^{between pp. 50 and 51} insert, these arms are the portions shown in green on each side of the open portion of the rocker.

". . . means adjustably movable about a pivot and acting upon bodily movement in one direction to slidably engage either arm of said rocker . . ." This is the first portion of the description of the positioning element

or tappet. This element is shown in red in each of the figures. Appellant's adjustably movable means is adjustably movable about the pivot 60, and in each of the other three tuners the adjustably movable means is adjustably movable about the pivot 9. In each of these tuners, when the adjustably movable means moves bodily in the direction of the rocker, it will slidably engage whichever arm of the rocker is in the closest position. This can be either arm of the rocker, depending upon the tilt that the rocker happens to have at the time of such engagement.

“. . . and push it in one direction to an angular position at which the movement of said rocker is arrested by the collision of said means and the oppositely moving other arm of said rocker; . . .” This is a further description of the action of the tappet with respect to the rocker. The tappet in each of the tuners behaves in this precise manner. In appellees' tuners, the positions illustrated on the insert between pages 50 and 51 are in each case the angular position at which the movement of the rocker, shown in green, is arrested by the collision of the tappet means (red) and the oppositely moving other arm of said rocker (the first arm being the one that was first engaged).

“. . . and a spring for holding said means in a normally inoperative position;” This is spring 73 in the patent drawing and spring 13 in the other tuners. In each case the function of the spring is to hold the tappet in a normally inoperative position in which it is out of engagement with the rocker.

“. . . said rocker constructed so as to admit at least a portion of said means between said arms.” This is the opening in the rocker to admit a portion of the adjustable means between the rocker arms so that the axis of the ad-

justable means may become coaxial with the axis of the rocker.

That is all of claim 7. It clearly does not include either a lever nor a plunger as an element of the combination. Aside from the spring, it calls only for the rocker and the tappet,¹ the elements shown on page 19 of this brief.

All of the elements of the claim are thus present in the plaintiffs' tuners, each functioning and constructed in the prescribed manner.

Like claim 7, claim 8 does not include the manual operating member as an element of the claim. It thus calls for neither a lever nor a plunger as an element of the combination. The difference between claims 7 and 8 is in the last clause and in the additional description of the rocker in the qualifying disclaimer on the back of the patent. The last clause of claim 8, instead of mentioning the opening in the rocker, specifies that the axis of the adjustable means must be "substantially co-axial with the axis of said rocker when said means is in engagement with both of said arms" (of the rocker).

Claims 9, 10 and 11 are substantially the same as claims 7 and 8 excepting that claims 9, 10 and 11 include a manual operating member. These claims do not specify what kind of a member this must be, because the tappet and the rocker do the real work of the combination, and it makes no difference to these elements whether the tappet is moved by a lever, a plunger, a wheel, a link, a pull-chain, or some other means.

¹The term "tappet" is seldom used in the industry. This element is usually referred to as a *cam*, *striker plate* or *disc*. The term "means adjustably movable about a pivot" has more significance than any of these shorter terms, especially when accompanied by a detailed description of what it does, as in claim 7.

When all of the elements of the claims at issue are present in the accused structure, each functioning in the manner prescribed, the usual criterion for infringement is fully met.

In the *Associated* case, this court held that the rocker and tappet of the accused device were the equivalents of the respective corresponding elements of the tuner shown in the patent, but it said that if the reissue claims “do not include levers, the claims are not for the same invention as the original patent and hence are invalid. If they do include levers, the claims are not infringed, for the accused device contains no lever.” Despite this conclusion, the court nevertheless recognized that the claims would still be infringed if the plungers were equivalents of the levers. So the court considered this question, but ruled that “the plungers and the levers are not equivalents.”

The record in the *Associated* case contained no prior art tuner patents to establish that plungers and levers were well known equivalents for operating automatic tuning devices. The vastly different record in the present case contains an abundance of irrefutable evidence on this score. Whether or not the original patent defined a combination that did not specify a lever is thus superfluous, but appellant nevertheless desires to double-clinch his case by showing that the original patent did define a combination in which a lever was not included.

d. THE STATED OBJECTS AS WELL AS ORIGINAL
CLAIM 5 DESCRIBED THE INVENTION WITHOUT
REFERENCE TO LEVERS.

When the original patent was applied for, levers and plungers were already optional equivalents for operating automatic tuners as well as for operating a wide variety of other devices. As this court knows, it is merely required that a patent show an illustrative embodiment of an invention. The doctrine of equivalents automatically extends the meaning of the terms of the claims to include the mechanical equivalents of the forms shown.

Fully mindful that a lever was only one alternative means for operating his combination, the patentee used the term *lever* in his specification proper only when he was describing the specific embodiment shown. [The specification of the original patent, R. Vol. II, p. 175, is identical to that of the reissue.] In all other parts of the explanation of his invention he used broad terms. Right in the objects he sought to preempt his right to any kind of a manually operable member by referring to the operating element in terms so broad that they cannot possibly be construed as referring just to a lever. On page 1, column 1, lines 19 and 20 of the original patent [R. Vol. II, p. 175], the term is "a simple manually operated control." In the same column, line 23, the reference is to "a single manual operation." This same term recurs in lines 28 and 29. In lines 31 and 32, it is "a definite manual operation." In the next column, line 8, in referring to the use of his invention for tuning in both sound and television, the patentee again uses the term "a single manual operation." The specification then begins to describe the specific embodiment illustrated.

Nowhere in the objects, where one must look for a patentee's intentions, do we find any reference whatever to a lever. The terms were clearly chosen to forestall the possibility of anyone's getting the idea that he intended to be confined to any specific kind of a manually operable member.

That the patentee did not regard any particular kind of an operating member as essential, is definitely shown by original claim 5 which did not even mention any kind of an operating means as an element of the combination. Claim 5 was confined to the rocker, the tappet, and a spring for moving the tappet to an inoperative position. This claim was directed to the same elements as re-issue claim 7, analyzed on preceding pages of this brief. Re-issue claim 7 describes these elements in greater detail, but the operating member is not included either in original claim 5 nor in reissue claims 7 and 8.

Claim 5 of the original patent thus set forth a combination that did not include a lever. But in quoting the claims and arriving at the statement that “No leverless combination is disclosed or claimed in the original patent” (137 F. (2d) at p. 726), the court omitted claim 5, explaining in footnote 12 (at p. 725): “For reasons heretofore stated, the patent is construed as if claim 5 had never been included therein.” The reason given for its omission was that this claim had been disclaimed from the re-issued patent. Although it has already been shown that the recited objects gave ample evidence that any kind of a manually operable member was contemplated, appellant contends that claim 5 should also have been considered, and that in construing the original patent for determining the patentee’s intent, the patent should have been construed just as it actually appeared when it issued from the Patent Office.

As indicated in footnote 7 of this court’s prior decision, the idea of omitting claim 5 when considering the original patent, grew out of the Supreme Court decision in *Altoona Publix Theatres v. American Tri-Ergon Corp.*, 294 U. S. 477, 491, which said that the disclaimer therein “speaks from the date of the original patent.” The disclaimer there discussed was a qualifying disclaimer which did not disclaim the claim in its entirety, but sought to limit its scope. The Supreme Court merely meant that for purposes of holding an infringer, a claim must be considered as if the limitations set forth in a limiting disclaimer had been in the claim right from the start. It is well known that a qualifying disclaimer does not merely apply after the date of the disclaimer, but that its limitations must be considered even when applying the claim to alleged infringements that took place between the date of the patent and the date of the disclaimer. This Honorable Court followed that practice when applying the claims as modified by a disclaimer in *Payne Furnace & Supply Co., Inc., v. Williams-Wallace Co.*, 117 F. (2d) 823. This is the way in which a disclaimer speaks from the date of the original patent.

The patent sued upon in the *Altoona* case was not a reissue patent. It was an original patent. When the Supreme Court said that the qualifying disclaimer speaks from the date of the *original* patent, it consequently referred to the very patent to which it was attached. A claim appearing in an original patent, regardless of what may happen to it thereafter, can without question be used for the purpose of determining what the patentee intended to claim. The Supreme Court never said anything to controvert this obvious, axiomatic statement. In the *Altoona* case, the Supreme Court decided an entirely different question.

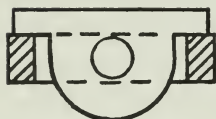
There are two ways of getting rid of an invalid claim: by a disclaimer, or by a reissue. Patents are reissued right along without some of the original claims; in fact, all of the original claims are frequently dropped and the patent reissued with an entirely different set of claims. If the patentee's intent is to be determined solely from the original claims that are not discarded, then an original patent all of whose claims are dropped must be construed as indicating that the patentee never intended to claim anything. If a patentee's intent is to be determined from the face of the original document, as the rule requires, then that face must be considered in its original unaltered state. Suppose that the defendant had suspected somewhat earlier that his claim 5 might not be valid and that he had therefore omitted it when the reissue was obtained. Clearly the claim could then be examined for evidence of his original intent. Why is it of any less value for this purpose if it is disclaimed after the reissue?

This court's interpretation of the *Altoona* decision creates a situation in which a patentee cannot disclaim one of his original broad claims from a reissue patent without retroactively affecting the validity of the reissue itself. Surely this court did not intend to render an opinion that would have this effect.

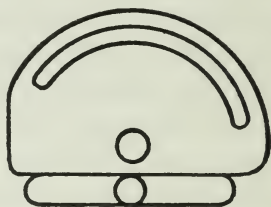
Let us see what Leishman actually relinquished through his disclaimer of claim 5.

This claim was broad in two ways: Inasmuch as it was immaterial what kind of a member be employed to impart motion to the tappet, claim 5 omitted the operating member entirely when listing the elements that were essential. In this respect it was in harmony with the broad objects as set forth in the original patent, and its breadth in this regard was proper. But the claim was also very broad in its description of the rocker and the movable means or tappet that engages the rocker.

When the patent was reissued, the patentee retained his original broad claim 5, which was directed to a single rocker and the tappet, but he added the group of much narrower claims 7 to 12. Like claim 5, they made no mention of a lever, but they were differentiated from claim 5 by the recitation of structure having to do with the coaxial relationship between the rocker and the adjustable positioning means in the completely engaged position. The only new claims in the reissue patent that mentioned the operating member at all, did so in broad terms like those which the patentee used in setting forth his intent in the objects of the original patent.



Coaxial



Noncoaxial

Claim 5 was broad enough to include both of these.

Appellant later learned that claim 5 read upon a device of the prior art. This device contained a rocker and a tappet, and claim 5 read upon it because this claim did not set forth any of the novel structural features that distinguished Leishman's coaxial tappet and rocker combination from the prior art. The claim was broad enough not only to include the type of rocker and tappet set forth in

the patent specification and drawing, but also to include rocker and tappet combinations like that shown at the right on page 28, in which there is no provision for one of these members to rest within the other in order to obtain the advantages of substantial coaxiality. Claim 5 accordingly had to be disclaimed, but the other leverless claims—claims 7 to 11—contained the necessary limitations and were consequently retained.

The disclaimer of claim 5 had nothing whatever to do with the fact that it did not contain a lever. If the patentee had been trying to disclaim leverless claims he would have disclaimed claims 7 to 11 also.

The effect of disclaiming any claim is merely to disclaim whatever that claim sets forth that is in excess of what is set forth in the claims that are retained. The disclaimer statute Sec. 4917 (U. S. C., title 35, sec. 65), says:

“Whenever, through inadvertence, accident, or mistake, and without any fraudulent or deceptive intention, a patentee has claimed more than that of which he was the original or first inventor or discoverer, his patent shall be valid for all that part which is truly and justly his own, provided the same is a material or substantial part of the thing patented. . . .”

In disclaiming claim 5, the patentee thus disclaimed any combination of a rocker and tappet that did not contain structure set forth in the other claims that were retained—regardless of whether the tappet is moved by a plunger or a lever or anything else, since this claim did not mention the operating member at all. Among the claims retained, were claims 7 to 11. Of these, claims 7 and 8 do not call for the operating means as an element of the combination; while claims 9, 10 and 11 describe this member in broad terms similar to those used in the objects of the original patent.

These objects in the original patent contained no limitation to a lever. Original claim 5 did not include a lever. The patent was reissued with seven leverless claims. After

the disclaimer of claim 5, the reissue patent still contains six leverless claims.

In their inclusion of leverless combinations, the original and reissue patents have thus all along been for the same invention. This is manifest on the faces of the documents themselves without regard to any of the new evidence.

e. THE REQUIREMENTS WITH RESPECT TO
EQUIVALENTS.

After expressing the conclusion that the reissue claims must be interpreted as including levers if they are to be for the same invention as the original patent, this court in the *Associated* decision recognized that the claims would still nevertheless be infringed if the accused tuner contained the equivalents of the elements in appellant's combinations. It accordingly considered whether such equivalents were present.

In this regard, the decision said at page 727: "It (the Crosley tuner) has a rocker which is the equivalent of appellant's rocker 48." This is the rocker utilized when the tuner is to be used for radio alone. The decision next stated: "It has no rocker 54 nor any equivalent thereof." Rocker 54 is employed when the tuner is used also to tune in television programs. Inasmuch as this second rocker is not included as an element in any of the claims at issue, the fact that a given tuner does not include this rocker has no bearing upon the matter of the infringement of *these* claims.

The court next said: "It (the accused tuner) has tappets each of which is the equivalent of appellant's tappet 61." This is the tappet that cooperates with rocker 48 in the claims at issue. The court then remarked: "It has no tappet 62 nor any equivalent thereof." Like the second rocker, this second tappet is only employed when the tuner is used for a dual purpose. This second rocker is not included as an element in any of the claims at issue, and the court therefore did not say that this omission had any significance to the issue of infringement.

Inasmuch as this court held that the rocker and tappet of the Crosley tuner were equivalents of the corresponding elements in the patent, this is also true of the appellees' tuners, for it has already been pointed out that appellees themselves contend that their devices are patentwise the same as the accused tuner in the *Associated* case.

Immediately following the portion last quoted, the *Associated* decision said: "It [the accused tuner] has no lever of any kind or character. Its tappets are operated (made to engage the rocker) by means of plungers. The plungers perform a part, and only a part, of the function performed by appellant's levers F and 66." In this regard footnote 17 stated that appellant's levers also operated a second tappet, and that the latter function was not performed in the accused device. The court did not say, nor could it have done, that the failure of the plunger to move a second tappet would in any way avoid the infringement of a claim not calling for a second tappet. The court rather said: "The part so performed is not performed in the same way, or in substantially the same way. Hence the plungers and the levers are not equivalents."

In the *Associated* case, there was nothing in the record to show that these two ways of moving tappets and other objects had long been used alternatively in the art, and that they were therefore equivalents. Moreover, the briefs presented in that case in behalf of the manufacturer were to the effect that the plunger method of operation originated with the Crosley Corporation. There was nothing in the record to prove otherwise, for all the tuner patents in the record of that case happened to show only levers as operating members. The court accordingly ruled that moving the tappets by means of plungers was not the equivalent of moving them by levers.

The prior art patents and other evidence presented in the present record in opposition to Plaintiffs' Motion for Summary Judgment, show that plungers and levers were

long known as mechanical equivalents in the art and that they were even used alternatively for the specific purpose of moving tappets.

In order that we may understand the significance of this new evidence, let us see what criteria the levers and plungers must meet to be considered proper substitutes—that is, full and complete mechanical equivalents under the law.

The doctrine with respect to equivalents was settled long ago in the Supreme Court case of *Seymour v. Osborne*, 11 Wall. (78 U. S.) 516, at 556, 20 L. Ed. 33 at 42, wherein the Court said:

“* * * Mere formal alterations in a combination in letters patent, however, are no defence to the charge of infringement, and the withdrawal of one ingredient from the same and the substitution of another which was well known at the date of the patent as a proper substitute for the one withdrawn, *is a mere formal alteration of the combination if the ingredient substituted performs substantially the same function as the one withdrawn.*” (Emphasis supplied.)

In the instant case, the function of the lever and the function of the plunger are not merely *substantially* the same; they are *identical*. The function in both cases is to move the tappet. The question then becomes, was a plunger “well known at the date of the patent as a proper substitute” for a lever.

In *Imhaeuser v. Buerk*, 101 U. S. 647, 656, 25 L. Ed. 945, the Supreme Court reiterates its well-established doctrine on this point, as follows:

“Pressure in a machine may be produced by a spring or by a weight; and where that is so, the one is a mechanical equivalent of the other. Cases arise also where a rod and an endless chain will produce the same effect in a machine; and where that is so,

the constructor in operating under the patent may substitute the one for the other, and still claim the protection which the patent confers. Exactly the same function in certain cases may be accomplished by a lever or by a screw; and where that is so, the substitution of the one for the other cannot be regarded as invention.

“Patentees of an invention consisting merely of a combination of old ingredients are entitled to equivalents, by which is meant that *the patent in respect to each of the respective ingredients comprising the invention covers every other ingredient which, in the same arrangement of the parts, will perform the same function, if it was well known as a proper substitute for the one described in the specification at the date of the patent.* Hence it follows that a party who merely substitutes another old ingredient for one of the ingredients of the patented combination is an infringer if the substitute performs the same function as the ingredient for which it is so substituted, and it appears that it was well known at the date of the patent that it was adaptable to that use.” (Emphasis added.)

In “Patents,” subtitled “A Text-Book Compilation of the Patent Decisions of the Supreme Court of the United States,” written by Beirne Stedman, LL. B., copyrighted in 1939 and published by The Michie Co., Charlottesville, Virginia, the settled doctrine with respect to when one element of a combination is the equivalent of another element, is stated as follows (section 194, p. 478):

“The extent to which either the inventor of a device or of an entire machine, or of a mere combination, can invoke the aid of the doctrine of equivalents, is the same, except that a combination is not infringed unless by a machine containing all of the material ingredients patented, *or proper substitutes for one or more of such ingredients*, well-known to

be such at the time when the patent was granted. Hence, the rule that the use of less than all of the elements of a combination does not constitute infringement is subject to the qualification that they must not be used in connection with a known equivalent for the omitted element. *By an equivalent in such a case it is meant that the ingredient substituted for the one withdrawn performs the same function as the other, and that it was well known at the date of the patent securing the invention as a proper substitute for the one omitted in the patented combination.*" (Emphasis added.)

f. THE PRESENT RECORD PROVES APPELLEES' PLUNGERS ARE THE EQUIVALENT OF THE LEVER SHOWN IN THE PATENT.

These controlling decisions of the Supreme Court and Stedman's digest of all Supreme Court decisions on this point, are very clear and definite. We know *exactly* what requirements the plunger must meet in order to be the equivalent of the lever. If they both perform the function with which we are here concerned—that of moving the tappet—and it was well known when the patent was granted that plungers and levers could both be used for such a purpose, then they are equivalents.

Now let us see if the evidence shows that plungers and levers were well known equivalents for such uses when the patent was granted.

Suppose we start with the patent right at the top of the list cited by the plaintiffs as constituting the most pertinent prior art. This list will be found in the complaint [R. Vol. I, p. 9]. The first patent on this list is No. 290,894, issued December 25, 1883, to Kettell. A copy of this patent appears in the books of exhibits [R. Vol. II, p. 177]. This patent is for a clock-setting mechanism, which, like the re-issue patent in suit, is concerned with the problem of rotating a shaft to a definite

position. Before electrically operated clocks came into wide use, it was customary to equip clocks in business institutions with an arrangement whereby they were automatically set to the correct time every hour by means of an electrical impulse transmitted over wires. The Western Union operated such a service, and the clocks were all set by an impulse transmitted from the U. S. Naval Observatory in Washington. In Kettell's clock, as shown on the first page of his drawings, the electrical impulse causes the electro-magnet K, Fig. 1, by means of appropriate intermediate mechanism, to move the lever E (shown in blue) so that the projections or tappets (colored red) that extend to the left will engage the rod D (green), causing it to turn to the position shown in dotted lines. Inasmuch as the rod D is connected to the minute hand, this action causes the minute hand to point straight up to XII. Regarding these parts, Kettell says (p. 1, lines 67 to 74):

"D represents a diametrically-arranged rod secured to or passing through the arbor of the minute-hand, so as to revolve with it.

"E is a vibrating lever, having two projecting arms on the side nearest the arbor of the minute-hand, and which are arranged to operate the rod D when it is necessary to set the clock."

Fig. 2, on the second page of the drawings, *shows a plunger "a" (colored blue) for performing exactly the same function as the lever shown on the first page.* This function is the moving of the tappets (red) to turn the minute hand to the straight up position shown in dotted lines. In this modification, the pins *f* on the disc perform the function of the rod D in the previous figure. Of this arrangement, the patent says on page 2, lines 81 to 83:

"*a* represents a slide [plunger] working in ways *b*, and having lateral arms [tappets] similar to lever F, Fig. 1 [obviously this should be the lever E, be-

cause F is the cam], *it serving the same purpose.*" (emphasis added.)

In this 1883 Kettell patent, we thus have levers and plungers "serving the same purpose," to use the language of the patent itself, and this purpose happens to be *the very same purpose* served by the levers and plungers with which we are concerned in this suit. Kettell uses either *levers* or *plungers* to move the *tappets* (the projections) that engage the *rocker* (the rod D or the disc g).

Levers and plungers were thus known as equivalents right in this same shaft-positioning art as far back as 1883, and the patent even *says* they serve the same purpose. For at least 53 years, then, levers and plungers have been known equivalents for performing such functions as those with which we are here concerned. And in the case of Kettell, the levers and plungers were even used to move tappets. *See insert →*

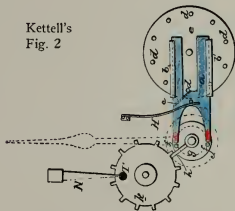
This Kettell patent was not in the record of the *Associated* case.

The Peck patent, No. 1,865,704 [R. Vol. II, p. 237] issued July 5, 1932, is another U. S. patent that shows the use of plungers for performing the function of the levers illustrated in appellant's patent. The drawings of the Peck automatic radio tuner will be found on pages 238 and 240 of the Book of Exhibits. In the Peck patent, as in that of Kettell, both plungers and levers are illustrated right in the drawings.

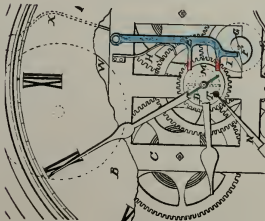
When Peck's lever 50, shown in blue in Fig. 3, is depressed, the mechanism moves through the intermediate position shown in Fig. 4 to the tuned-in position shown in Fig. 5. It will be observed that two links, 12 and 13, are attached to opposite sides of the disk 11, and that the opposite ends of these links are connected respectively to links 18 and 19. The lower ends of the latter two links are both pivoted at 20 to the lever 40 which moves as a unit with lever 50. As the links are stretched out in response to the downward movement of the operating

THAT PLUNGERS AND LEVERS ARE EQUIVALENTS FOR MOVING TAPPETS WAS KNOWN IN 1883

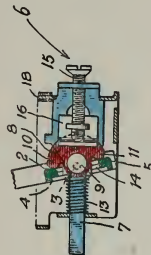
Kettell's
Fig. 2



From Kettell's Fig. 1 (below)



Moving tappets by means of plungers with guides, is the equivalent of moving tappets by means of levers with pivots. This substitution was used by Kettell in 1883. See figures at left.



In substituting the plunger at the left for the lever shown below, the infringer merely substituted a well known mechanical equivalent, as shown by Kettell

Infringement is not averted thereby. See 78 U. S. 516, 20 L. Ed. 53,

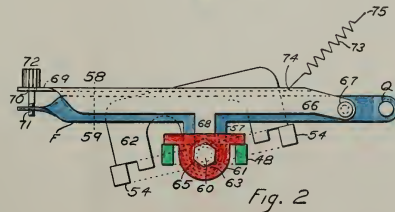


Fig. 2

From Reissue Patent No. Re.20,827

cause F is the cam], *it serving the same purpose.*" (emphasis added.)

In this 1883 Kettell patent, we thus have levers and plungers "serving the same purpose," to use the language of the patent itself, and this purpose happens to be *the very same purpose* served by the levers and plungers with which we are concerned in this suit. Kettell uses either *levers* or *plungers* to move the *tappets* (the projections) that engage the *rocker* (the rod D or the disc g).

Levers and plungers were thus known as equivalents right in this same shaft-positioning art as far back as 1883, and the patent even *says* they serve the same purpose. For at least 53 years, then, levers and plungers have been known equivalents for performing such functions as those with which we are here concerned. And in the case of Kettell, the levers and plungers were even used to move tappets. *See insert →*

This Kettell patent was not in the record of the *Associated* case.

The Peck patent, No. 1,865,704 [R. Vol. II, p. 237] issued July 5, 1932, is another U. S. patent that shows the use of plungers for performing the function of the levers illustrated in appellant's patent. The drawings of the Peck automatic radio tuner will be found on pages 238 and 240 of the Book of Exhibits. In the Peck patent, as in that of Kettell, both plungers and levers are illustrated right in the drawings.

When Peck's lever 50, shown in blue in Fig. 3, is depressed, the mechanism moves through the intermediate position shown in Fig. 4 to the tuned-in position shown in Fig. 5. It will be observed that two links, 12 and 13, are attached to opposite sides of the disk 11, and that the opposite ends of these links are connected respectively to links 18 and 19. The lower ends of the latter two links are both pivoted at 20 to the lever 40 which moves as a unit with lever 50. As the links are stretched out in response to the downward movement of the operating

lever, the disk 11 and shaft 10 are turned in a manner that will be obvious from the drawings. When the parts have reached the final position shown in Fig. 5, the position of the disk will always be the same. The station that will then be tuned in will depend upon the angular position of the disk with respect to the shaft. This relative angular position is fixed when the tuner is "set" or adjusted so that each of the series of operating members will bring in a pre-determined station. Regarding this setting operation, the Peck specification says (page 2 of the patent, lines 48 to 54):

"In order to effect a positioning of the shaft at any desired angle, adjustment of the disk 11 with respect to the shaft 10 is permitted by mounting the disk 11 for free rotation thereon, the disk 11 being locked to the shaft at any desired position of adjustment by means of a set screw 25."

Inasmuch as plungers and levers were well-known equivalents for transmitting motion to various parts of a mechanism at the time when Peck's specification was written, and had been used in this art since the last century, it was not necessary for him to mention that his apparatus could be operated by plungers. He merely says (page 2 of the patent, lines 69 to 76):

"*Various expedients may be adapted to cause the downward movement of the pivot 20.*" (It will be obvious from an examination of Figs. 3, 4 and 5 that it makes utterly no difference what is used to move the pivot 20 downward.) "In Figure 2 the pivot 20 is carried on the armature (plunger) 30 of the solenoid coil 31 so that, when the solenoid is energized and the armature 30 drawn therein the pivot 20 is pulled downwardly, effecting the actions heretofore described." (Emphasis and parenthetical explanations added.)

On page 3, lines 4, 5 and 6, Peck makes another brief reference to this arrangement, as follows:

“As an alternative for the manually actuated keys, the electrically actuated mechanisms as shown in Figure 2 may be adopted.”

In the instant case, appellees' use of a plunger instead of a lever was the mere substitution of one well-known mechanical equivalent for the other in the same manner and for the same purpose illustrated in the Peck patent. This is graphically shown on page 39 of this brief, where Peck's Figs. 3, 5 and 2 have been reproduced. In Peck's device, the pivot 20 is alternatively placed on a lever (Fig. 3) or a plunger (Fig. 2), in accordance with his statement that “Various expedients may be adopted to cause the downward movement of the pivot 20”.

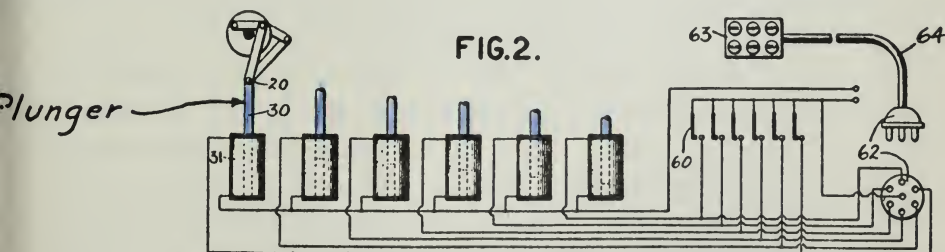
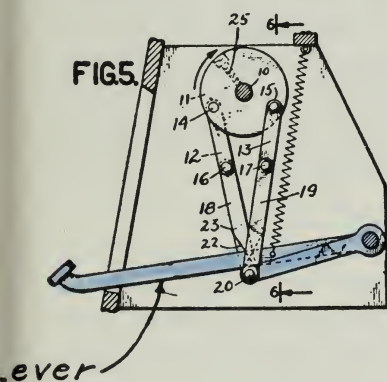
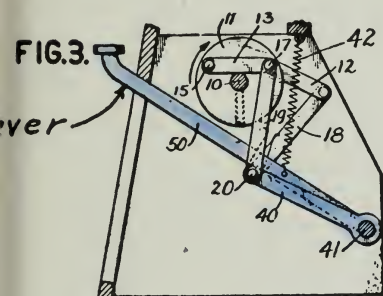
In the device of the reissue patent in suit, as shown on page 15 hereof, the tappet 61 is pivoted on the extension 57 of the lever F by means of a pin 60. The reprint from Plaintiffs' Exhibit 3 shows the tappet 8 of the accused device pivoted on the plunger by means of the pin or rivet 9. In one case the tappet is moved by a lever, and in the other case the tappet is moved by a plunger. The function is thus identical in both instances.

The Peck patent was not in record of the *Associated* case.

For another illustration of the well-known equivalency of levers and plungers for the purposes with which we are concerned, let us take the Danish patent No. 52,047, issued August 11, 1936, to the N. V. Philip's Glowlamp Factory. A copy of this patent, certified by the U. S. Patent Office, is present in the Book of Exhibits on pages 253, 254 and 255, and a certified translation will be found in the Book of Exhibits on pages 247 to 252, inclusive.

Figures 1 and 2 from this Danish patent are reproduced on the insert between pages 42 and 43, together with an additional figure showing a modification described in the Danish patent but not shown in the drawings.

PECK 1932 PATENT SHOWS PLUNGERS AND LEVERS USED AS EQUIVALENTS



Figs. 2, 3 and 5 from the 1932 Peck Patent, show the substitution of a plunger in Fig. 2 for the lever in Figs. 3 and 5.

Similarly, the Appellees merely substituted a plunger for a lever in Appellant's combination.

"A party who merely substitutes another old ingredient for one of the ingredients of the patented combination is an infringer, if it appears that it was well known at the date of the patent that it was adaptable to that use." 101 U. S. 647, 655.

Beginning at the bottom of page 248 of Volume II of the record, the translation describes the construction and operation of the Danish tuner as follows:

“In the working plan shown in Fig. 1, a number of curved discs are placed upon the shaft which is to be adjusted; for simplicity’s sake only one is shown in the drawing. Each of the curved discs cooperates with a plunger 3, disposed in the plane of the disc which is at right angles to the shaft 1, the plunger being guided in a stationary member 5. On the end of plunger 3 is placed a button 6; when this button 6 is pressed, the plunger is shifted; and a spring 7, placed between this button 6 and the stationary member or frame 5, serves the purpose of bringing plunger 3 back to rest position when the button 6 is released. The periphery of the curved disc 2 is so formed that whenever a roller 3a, or something similar, is placed on the end of the plunger, it collides with the curved disc and creates a force, or moment, that causes shaft 1 to turn. Any form of periphery which satisfies this condition may be utilized.”

* * * * *

“In this working plan, shaft 1 will by each adjustment always be turned in the same direction. If this is not necessary, a purposely heart-shaped form, as shown in figure 2, can be used instead of the spiral-shaped periphery of the curved disc.

“In the figures 2 and 3 there is shown a shaft 1, which is to be adjusted, and a number of heart-shaped curved discs 2. Cooperating with these curved discs are a number of levers 4 which are advantageously located on a common shaft 9 which is parallel to shaft 1. The free ends of the levers are linked with plungers 3 which can be moved down in frame 5 by means of the buttons placed on their

upper ends. The return movement occurs as in the working plan shown in figure 1 by means of springs 7. When one of the plungers 3 is moved downward, it will cause the lever 4, which is connected thereto, to be turned around shaft 9, until it is tangential with the corresponding curved disc 2 and thereby turn it and shaft 1 to a predetermined position which, in the form shown, is determined by lever 4 touching the curved disc at two points."

The second of these three paragraphs quoted from the Danish translation, says that heart-shaped discs may be used in the device of Fig. 1 instead of the spiral shaped type when it is not necessary that the shaft always be turned in the same direction. If such a heart-shaped disc is used in the device of Fig. 1, we will have the arrangement shown at the left of Fig. 1 on the insert between pages 42 and 43. The difference between this form and the form shown in Fig. 2, lies only in the fact that the roller 3a (acting as a tappet, and shown in red) is pivoted to a plunger (blue) in the figure at the left, and to a projection on the lever (blue) in Fig. 2.

The substitution illustrated and described in the Danish patent is precisely the same substitution of a well-known mechanical equivalent that appellees have made in appellant's structure. The Danish patent teaches that a tappet can be mounted either on a lever or a plunger to operate an automatic tuner. Appellees have made this same substitution by mounting their tappet upon a plunger instead of a lever as shown in appellant's patent.

The Danish patent was not in the record of the *Associated* case.

The three patents already discussed proved beyond any doubt that it was well known in this art when appellant's patent was granted, that plungers could be used as substitutes for levers in the operation of automatic tuners, and even for the specific purpose of moving tappets. The Supreme Court has repeatedly said, and never rendered a

decision to the contrary, that infringement cannot be avoided by omitting one element from a patented combination and substituting another that was well known as a proper substitute when the patent was granted. (See quotations from the Supreme Court and from Patents by Stedman on pages 32, 33 and 34 of this brief.)

Various other examples of the use of plungers for operating automatic tuners will be found in the prior art patents in the Book of Exhibits.

The Bast patent, in Vol. II, pages 186, *et seq.*, was issued in 1928. As will be seen in Fig. 2, page 186, it used a single plunger, 12, colored blue, which had an end that served as a tappet. Different stations could be tuned in by pushing this plunger into the various holes 12 so as to engage the rockers 6.

The Bast patent was not in the record of the *Associated* case. Aside from Leishman's own patents, the Exhibits in that action contained only three automatic tuner patents. These were the Schaefer, Flaherty and Marschalk patents in the then Defendant's Exhibit J. All of these were operated by levers. Inasmuch as a court can take judicial knowledge of its own records, it might be pertinent to state that these prior art tuner patents in the *Associated* case will be found in that record in Volume III, pages 585, 605 and 639 respectively.

On page 190 of the present Book of Exhibits, the court will find another patent describing a prior art tuner that was operated by plungers. This patent issued to Marvin in 1929. It employed a series of plungers 2, 3, 4, 5, 6 and 7—one for each station.

The British patent to Freytag, beginning on page 201 of Volume II, shows a whole series of operating plungers in Fig. 3 at the lower left of page 204. Many other plungers, identified by the numeral 15, appear in other figures.

The court did not have the benefit of this Freytag patent when the *Associated* decision was rendered.

Figure drawn according
to modifications explained in
Danish Patent No. 52,047.

Figs. 1 and 2 from Danish Patent No. 52,047,
issued Aug. 11, 1936.

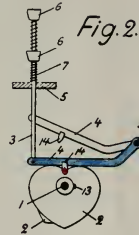
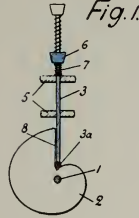
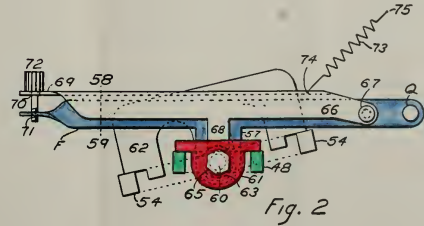
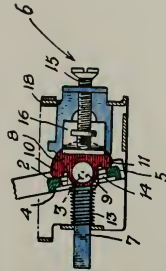


Fig. 2, left, from Danish Tuner Patent
No. 52,047, shows the roller (red) mounted
upon a lever, while Fig. 1, from the same
patent, shows the roller 3a mounted upon a
plunger.

Figs. 1 and 2 from the
Danish Patent, reproduced
above, show that it was
known in 1936 that a plun-
ger could be substituted for
a lever in an automatic tun-
ing mechanism.



Appellees' coaxial rocker and tappet combination (left) is the equivalent
of Appellant's coaxial rocker and tappet combination (right).

Operating this combination by a plunger instead of a lever does not avoid
infringement

The Gerdes patent [R. Vol. II, p. 208] did not disclose an automatic tuning device, but, like the patent in suit, is dealt with the problem of turning rotatable shafts to predetermined angular positions. The Gerdes patent was issued in 1902. Each of the plungers 8, Fig. 1, carried a tappet 10, Fig. 2. This patent was not in the record of the *Associated* case.

Pages 223, 224 and 225 of the record herein are reproductions of a certified copy of a German patent issued to the internationally known firm of Siemens & Halske. It is preceded in the record by a certified translation, beginning on page 218. This patent, issued in 1926, was concerned with the same problem presented in automatic tuners—the problem of turning rotatable shafts to predetermined angular positions. As in the Kettell device, previously described, the German instrument was used for setting clocks. The complete plunger will be seen in the lower figure on page 225. The operation of the device will doubtless be clear from the eight upper figures. Each plunger carries two tappets 2 and 3. This German device thus affords another example of the well-known use of plungers for moving tappets and positioning shafts before the patent at issue was granted. The court did not have the benefit of this patent when it rendered the *Associated* decision.

The Jacke Patent, page 228 of the Book of Exhibits, was issued to the Philco Corporation in 1942 on an application filed in 1928. Its operating plungers 11 can be clearly seen in Figs. 1, 2 and 3. This patent was not in the record of the *Associated* case.

In addition to the above patents, the present record contains sixteen other exhibits showing the alternative use of plungers and levers for operating well known devices and instruments. These are consecutively numbered from 1a to 16b and are attached together in one document according to the stipulation approved on page 166

of Volume I of the Record. The affidavit of LeRoy J. Leishman [R. Vol. I, p. 46] certifies that all of the things shown in these sixteen exhibits were in existence before February 15, 1938, which was the issuing date of original Patent No. 2,108,538 that was reissued as the patent in suit.

The evidence herein presented proves beyond any possibility of refutation that appellees' plungers are the equivalents of the levers of the reissue patent, according to the formula for mechanical equivalents laid down by the Supreme Court and discussed on pages 32, 33 and 34 of this brief. To reiterate one sentence of the Supreme Court decision in the *Seymour v. Osborne* case, *supra*:

"Mere formal alterations in a combination in letters patent, however, are no defence to the charge of infringement, and the withdrawal of one ingredient from the same and the substitution of another which was well known at the date of the patent as a proper substitute for the one withdrawn, is a mere formal alteration of the combination if the ingredient substituted performs substantially the same function as the one withdrawn."

Inasmuch as appellees' plunger performs not merely "substantially the same function," but *identically* the same function, and was well known as a proper substitute for the lever described in the specification at the date of the patent, the plunger is thus a proper substitute, or the mechanical equivalent, of the lever. *This is not a matter of opinion. It is a fact; but a fact that was not shown in the record before this Circuit Court of Appeals when its decision was rendered in the previous case.* In the light of this newly presented evidence, the former decision regarding the plunger and the lever is no longer controlling; and no possible holding can now be made, consistent with this evidence, excepting that the plunger is the equivalent of the lever.

“That Which Is Common and Well Known Is as If It Were Written Out in the Patent and Delineated in the Drawings,” Says the Supreme Court.

The new evidence presented is significant to the matter of infringement in yet another way. In *Carnegie Steel Co. v. Cambria Iron Co.*, 185 U. S. 403, at page 437, the Supreme Court said:

“* * * The specification of the patent is not addressed to lawyers, or even to the public generally, but to the manufacturers of steel, and any description which is sufficient to apprise them in the language of the art of the definite feature of the invention, and to serve as a warning to others of what the patent claims as a monopoly, is sufficiently definite to sustain the patent. He may assume that what was already known in the art of manufacturing steel was known to them, and, as observed by Mr. Justice Bradley, in *Webster Loom Co. v. Higgins*, 105 U. S. 580, 586, ‘He may begin at the point where his invention begins, and describe what he has made, that is new, and what it replaces of the old. *That which is common and well known is as if it were written out in the patent and delineated in the drawings.*’” (Emphasis added.)

Inasmuch as we have shown that plungers and levers were well known equivalents, the appellant’s patent must consequently be considered as if the use of a plunger for moving the tappet “were written out in the patent and delineated in the drawings.” Appellees can thus not possibly escape the charge of infringement on the ground that they have used a plunger instead of a lever for moving the tappet.

All the additional evidence now presented, and which was not before the Circuit Court of Appeals when it rendered the previous opinion, even changes the interpretation that is to be placed upon the *original* patent.

The Supreme Court doctrine that "that which is common and well known is as if it were written out in the patent and delineated in the drawings," of course applies to the *original* patent as well as to the reissue; and it can therefore no longer be held that the disclaimer of claim 5 from the reissue had the effect of removing the evidence that levers are not required; for even if the Circuit Court was correct in disregarding claim 5, the patent itself must be construed as if the use of a plunger for moving the tappet "were written out in the patent and delineated in the drawings."

Not only is this doctrine the law of the land, it is just plain common sense that necessarily underlies patents generally. If every patent had to illustrate and describe every known equivalent for each of the elements of each of the claims, all patents would be twice or three times their present length and many would comprise volumes.

A Former Decision Is Stare Decisis as Far as the Evidence Is the Same; But Where the Evidence Is Different, a New Decision Must Be Rendered.

It is of course unnecessary to cite decisions to the effect that the opinion of this court in the earlier case should be followed on matters regarding which the facts and the record are substantially the same, as we find in the instant action with respect to the rockers and tappets. It may be well, however, to cite cases dealing with the proposition that on matters on which the evidence is different, as regards the equivalency of the levers and plungers, a new decision must be rendered on the basis of the new evidence. The Second Circuit Court of Appeals, in dealing with new evidence, said:

"The plaintiff has appealed from a judgment dismissing its complaint with respect to a charge of infringement of Design Patent No. 125,540. By amended answer the defendant set up that the patent

had been held invalid by this court in the case of Gold Seal Importers v. Morris White Fashions, 2 Cir., 124 F. 2d 141, and moved for judgment on the pleadings. The motion was granted on the ground that the validity of the patent had been decided adversely to the plaintiff in that case. But obviously that decision cannot be pleaded as *res judicata* in a suit against a different infringer not in privity with Morris White Fashions. *Nor is it a precedent which the district court was bound to follow, unless the evidence pertinent to the issue of validity is the same in both cases.*" (Emphasis added.) *Gold Seal Importers, Inc., v. Westerman-Rosenberg, Inc.*, 133 F. 2d 192, C. C. A. 2.

Because of the presence of new evidence in the foregoing case, the very Circuit Court that had rendered the previous opinion remanded the case to the District Court for a determination of the issue on the basis of the new evidence. In the instant case, the new evidence is incontrovertible and this court should therefore render a new decision in conformity therewith.

Neither the Circuit Court of Appeals nor the Supreme Court considered even a former decision of the Supreme Court itself to be binding with respect to the same patent when new evidence was introduced and one of the litigants was different. Said the Supreme Court:

"In *Smith v. Snow* (1935) 294 U. S. 1, 55 S. Ct. 279, 79 L. Ed. 721, we held the patent valid and infringed. *But in that case the Hastings prior use was not presented or considered.* * * *

"The decrees of the District Courts rejecting the defense were reversed by the Court of Appeals for the Second Circuit, *Smith v. Hall*, 83 F. (2d) 217, *Smith v. James Mfg. Co.*, 83 F. (2d) 221, which found prior use by Hastings." (Emphasis added.) *Smith v. Hall et al., Same v. James Mfg. Co. et al.*, 301 U. S. 216 at 218, 57 S. Ct. 711 at 712.

Each of the three District Courts mentioned in the two cases above quoted, were held to be wrong in following a decision of a Circuit Court of Appeals or even of the Supreme Court when new evidence was presented with respect to the same patent. A single new item of pertinent evidence in the two *Smith* cases was sufficient to cause the Supreme Court to affirm the Circuit Court in its new decision which was at variance with the one rendered by the Supreme Court in the previous case in which this single item of evidence "was not presented or considered," as the Supreme Court put it.

In the instant case, appellant has presented not a mere *single* item of new evidence, but *numerous* items, *each* of which is *alone* sufficient to prove that levers and plungers were known equivalents when the original and re-issue patents were issued, and moreover, that they were known equivalents in this very art. The Circuit Court's previous opinion regarding the patent here at issue must therefore be modified with respect to the plungers in the accused devices.

Claims 7 and 8, which did not include the operating member, have already been applied to the accused tuners. Now that it has been established that plungers were known as operating members when the patent was granted, it may be well also to apply the other claims to appellees' devices.

Claim 9 reads: "In a mechanism for angularly positioning a control of a radio device, a combination including: . . ." The plaintiffs' tuners obviously qualify as mechanisms of the type described in this preamble.

". . . a rotatable rocker comprising two shoulders lying on opposite sides of the axis of said rocker; . . ." These shoulders are the opposite sides of the rocker shown in green in the various figures of plaintiffs' devices. This element in the Crosley tuner in the *Associated* case was held by this court to be the equivalent of the correspond-

ing element of the patent. Appellees admit that their tuners are like the Crosley tuner. (*See insert after p. 50.*)

“ . . . and a manually movable operating means comprising an adjustably mounted positioning element . . . ” This means is the subassembly consisting of the plunger and the adjustably mounted positioning element or tappet 10.²

In the qualifying disclaimer printed on the back of the patent [R. Vol. II, p. 172] the adjustably mounted positioning element is further described as “so adjustably mounted that it may be fixed and maintained in its adjusted position irrespective of repeated operations of said operating means.” This is the obvious reason for the adjustable mounting of the positioning element in the appellant’s tuner as well as in those manufactured by appellees.

“ . . . adapted upon movement of said means in one direction to engage one shoulder of said rocker and rotate said rocker to a position at which the movement of said element is arrested by the collision of said element and the oppositely moving other shoulder of said rocker;” This is a further description of the positioning element, or tappet. Inasmuch as appellees allege that their tuners are the same as the Crosley tuner whose tappet was held to be the equivalent of the tappet in the reissue patent, it follows that appellees’ tappets are also responsive to defendant’s claims.

“ . . . said rocker constructed to permit at least a portion of said means to pass beyond a line connecting the points on said shoulders at which the shoulders are contacted by

²In the footnote on page 23 of this brief, it was pointed out that the term “tappet” is seldom used in the industry, and that this element is usually referred to as a *cam*, *striker plate* or *disc*. Appellant believes that the term “adjustably mounted positioning element” is far more accurate and descriptive than any of these other terms, because this element *positions* the rocker and *it must be adjustably mounted*.

said means.” This is additional description of the rocker. It has already been established that appellees’ rockers are equivalents of the rocker of the patent.

Claim 10. “In a mechanism for angularly positioning a control of a radio device, a combination including: a rotatable rocker comprising two shoulders lying on opposite sides of the axis of said rocker; . . .” This part of claim 10 is the same as the first part of claim 9, which has already been applied to appellees’ tuners.

“. . . a manually movable operating member;” Appellees’ tuners obviously contain *a manually movable operating member*. It has been shown that appellees’ plungers are proper substitutes for the levers shown in the patent, and that they were well known as such before the date of the patent.

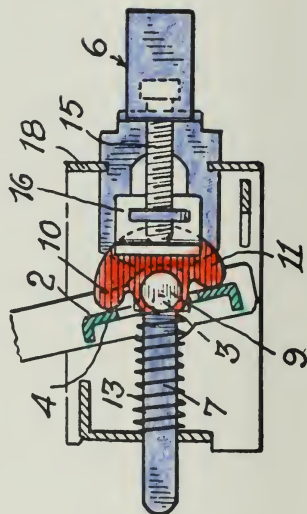
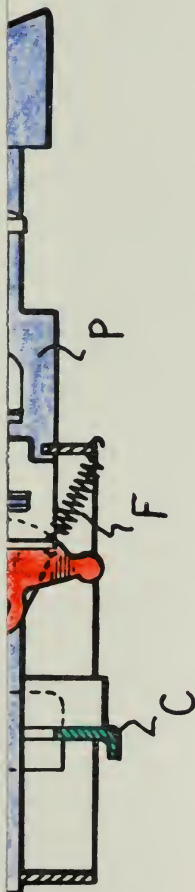
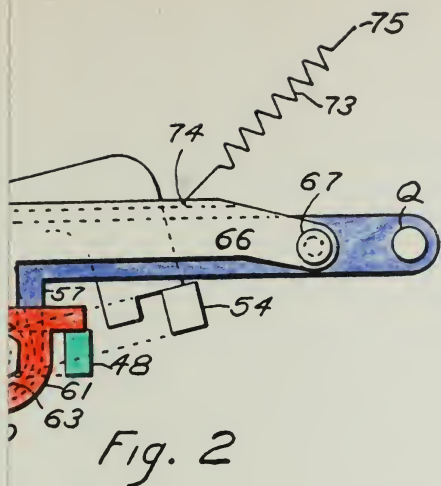
The balance of claim 10 describes the rocker and tappet. These need not be discussed, because appellees’ entire structures are admitted to be the same as the Crosley tuner in which this court held the rocker and tappet to be equivalents of those shown in the patent in suit. The qualifying disclaimer qualifies the adjustable mounting in the same way as in claim 9.

Claim 11 is substantially like claims 9 and 10 excepting for the fact that it calls for an additional element, the “means operable from the external end of said member for holding said element in adjusted position.” This is the screw identified in Plaintiffs’ Exhibits 1 and 3 by the numeral 15 [R. Vol. I, pp. 12, 13]. It is obviously operable from the external end of the plunger member.

Like claim 7, claim 11 is not modified by a qualifying disclaimer.

All the claims at issue are manifestly infringed.³

³The U. S. District Court for the Western District of Oklahoma rendered its decision in the aforesaid Oklahoma case after a full trial at which appellant presented the same ten prior art patents and 16 other exhibits that are a part of the instant record. The



Above, drawing of appellee General Instrument Corporation tuner from the complaint, R. Vol. I, p. 13.

Bottom center, drawing of Crosley tuner from the complaint herein, R. Vol. 1, p. 14.

said means.” This is additional description of the rocker. It has already been established that appellees’ rockers are equivalents of the rocker of the patent.

Claim 10. “In a mechanism for angularly positioning a control of a radio device, a combination including: a rotatable rocker comprising two shoulders lying on opposite sides of the axis of said rocker; . . .” This part of claim 10 is the same as the first part of claim 9, which has already been applied to appellees’ tuners.

“. . . a manually movable operating member;” Appellees’ tuners obviously contain a *manually movable operating member*. It has been shown that appellees’ plungers are proper substitutes for the levers shown in the patent, and that they were well known as such before the date of the patent.

The balance of claim 10 describes the rocker and tappet. These need not be discussed, because appellees’ entire structures are admitted to be the same as the Crosley tuner in which this court held the rocker and tappet to be equivalents of those shown in the patent in suit. The qualifying disclaimer qualifies the adjustable mounting in the same way as in claim 9.

Claim 11 is substantially like claims 9 and 10 excepting for the fact that it calls for an additional element, the “means operable from the external end of said member for holding said element in adjusted position.” This is the screw identified in Plaintiffs’ Exhibits 1 and 3 by the numeral 15 [R. Vol. I, pp. 12, 13]. It is obviously operable from the external end of the plunger member.

Like claim 7, claim 11 is not modified by a qualifying disclaimer.

All the claims at issue are manifestly infringed.³

³The U. S. District Court for the Western District of Oklahoma rendered its decision in the aforesaid Oklahoma case after a full trial at which appellant presented the same ten prior art patents and 16 other exhibits that are a part of the instant record. The

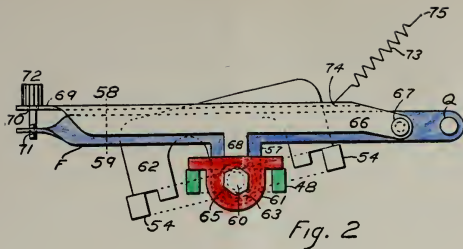
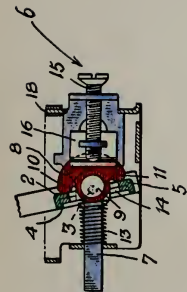
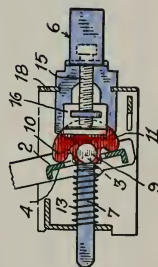
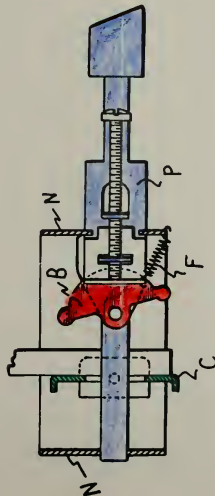


Fig. 2



Top center, drawing from
appellant's patent.

Above, drawing of appellee
Radio Condenser Company
tuner from the complaint.
R. Vol. I, p. 12.



Above, drawing of appellee
General Instrument Corporation
tuner from the complaint.
R. Vol. I, p. 13.

Bottom center, drawing of
Crosley tuner from the
complaint herein, R. Vol. 1, p. 14.

In view of the now established equivalency of the plungers and levers, this court's former decision should not have been followed by the lower court. However, it is now this court's province to say that the doctrine of *stare decisis* cannot apply.

"The rule of *stare decisis* is not so imperative or inflexible as to preclude a departure therefrom in any case, but its application must be determined in each case by the discretion of the court, and previous decisions should not be followed to the extent that error may be perpetuated and grievous wrong be the result." 21 *Corpus Juris Secundum*, page 322.

If the issue of infringement were to be reconsidered at a trial, no evidence could possibly prove that a plunger was not well known as the equivalent of a lever when the patent was granted. This Honorable Court should therefore reverse the lower court on the matter of infringement instead of remanding the case for a trial of this issue. If the case were remanded, any decision made by the lower court would merely come back to this court on appeal. A ruling should therefore be made at the present time that plungers were well known in the art as substitutes

following pertinent findings of the Oklahoma court may therefore be of interest [R. Vol. I, p. 53 *et seq.*]:

6. Claims 7, 8, 9, 10 and 11 of the reissue patent No. 20,827 are clearly valid, and clearly infringed due to the use of tuning devices in the following radio receiver sets manufactured by said Galvin Manufacturing Corporation and sold by defendant: Models 25F, 26C, 26C-7, 27D, 28-O, 30-P, 29-B, and 29B-6. This finding is made without any regard to any commercial success which plaintiff's tuners have attained.

11. The tappet or positioning element described in plaintiff's reissue patent No. 20,827 may be mounted either on a lever or a plunger to move the tappet, since a lever and a plunger perform their functions in the same way and are mechanical equivalents.

12. The finding 11 is based not only upon the evidence offered on behalf of plaintiff, but also upon the direct testimony of defendant's expert, Dr. Spotts, who testified to the effect that the substitution of plungers for levers is a simple

for levers in automatic tuning devices and even for the specific purpose of moving tappets, and that appellees cannot avoid infringement by omitting one element of the combination and substituting another that was well known as a proper substitute at the time of the grant of the patent.

There is another very good reason why this court should rule now on these matters relating to levers and plungers. Counsel for appellees have filed another declaratory judgment suit in this same district against appellant on behalf of another manufacturer, Civil Action No. 5781-Y, setting forth that it manufactures a tuner that is patentwise the same as the Crosley tuner. In the trial of that suit, the District Court should have the benefit of this court's opinion in the light of the new evidence, on the effect of operating appellant's combination with a plunger.

one in the combination covered by claims 7, 8, 9, 10 and 11 of the said reissue patent.

16. The use of plungers for operating mechanical automatic tuners was known long prior to plaintiff's development of his patented structure set forth in the reissue patent in suit.

26. The infringing tuners sold by defendant are exemplified generally by the defendant's exhibits G and H. These infringing devices were manufactured respectively by Radio Condenser Company and General Instrument Corporation, which are the joint plaintiffs in an action now pending in the District Court of the United States, Southern District of California, Central Division, and entitled: Radio Condenser Company and General Instrument Corporation v. LeRoy J. Leishman, No. 4395 B.H.

27. The tuners referred to in Finding 26 do not differ in any essential respect, so far as the question of infringement is concerned, from the tuner manufactured by Crosley Corporation of Cincinnati, Ohio, and which was the accused device in the action entitled LeRoy J. Leishman v. Associated Wholesale Electric Co., tried in the Southern District of California and reported in 36 F. Supp. 804. In said action, the Circuit Court of Appeals for the Ninth Circuit rendered its opinion, reported in 137 F. (2d) 722.

Appellees Are Bound by the Oklahoma Decision Because of Their Participation in the Defense of That Suit.

On June 21, 1946, appellant filed a Motion under Rule 15(d) [R. Vol. I, p. 63 *et seq.*] for permission to file a supplemental answer to the complaint and a second supplemental answer to the counterclaim [R. Vol. I, p. 72 *et seq.*] setting forth the additional defense that appellees herein are bound by the opinion in the Oklahoma case because of their participation in the defense of that action. The Motion under Rule 15(d) was supported by an Affidavit [R. Vol. I, p. 69 *et seq.*]. A copy of the Oklahoma Findings of Fact, Conclusions of Law, and Judgment had already been filed, and a copy will be found in Volume I of the Record, beginning on page 52.

When appellant filed his Motion under Rule 52(b) [R. Vol. I, p. 100] on October 16, 1946, there had not yet been any decision on the Motion under Rule 15(d) filed on June 21, 1946. In the meantime, the Oklahoma record had been transcribed, and the defendant filed a portion of it as his Exhibit 17 [R. Vol. I, p. 103 *et seq.*], in support of both of these motions. The Motion under Rule 15(d) for permission to supplement the answer was denied on December 18, 1946 [R. Vol. I, pp. 133 and 134].

Rule 15(a) of the Rules of Civil Procedure provides that permission to amend the pleadings be freely granted whenever justice so requires. Not only was the additional defense a proper one entitling appellant to a trial, but the documents filed in connection with the motion were alone sufficient to establish the defense. This Honorable Court should therefore instruct the lower court to enter the supplemental pleadings together with a judgment to the effect that appellees herein are bound by the Oklahoma judgment.

If a third party who has the legal right to assume the defense of an action, participates in the control of the

defense of said action in any way, the law provides that such third party is bound by the decision therein. This brief will show that appellees herein not only participated in the control of the defense of the Oklahoma action, but that the said defense was merely a presentation of what was prepared and furnished by the present appellees; and the law will then be applied to the evidence to show that appellees are bound by the decision in the Oklahoma case, and this Honorable Court should so hold.

The manner in which appellees participated in the control of the defense in the Oklahoma action is disclosed in the affidavit of Maxwell James, attorney in patent causes for both appellees; by recorded statements made before the United States District Court for the Western District of Oklahoma by Foorman L. Mueller, counsel for The Richards and Conover Company, defendant in the Oklahoma suit; and by the testimony of the expert witness for the said The Richards and Conover Company. Mr. Mueller's statements and the testimony of the said expert witness are included in the portions of the transcript of the Oklahoma trial constituting Defendant's Exhibit 17 [R. Vol. I, p. 103 *et seq.*].

Mr. Maxwell James, in his affidavit filed in behalf of the appellees [R. Vol. I, p. 66 *et seq.*], says:

"* * * I am and have been for many years the attorney in patent causes for both of the plaintiffs in this suit, namely Radio Condenser Company and General Instrument Corporation."

Mr. James then explains in his affidavit [R. Vol. I, p. 67]:

"(a) On April 2, 1946, Mr. Mueller called deponent on the telephone from Chicago, and informed the deponent that Judge Chandler was compelling Mr. Mueller to go to trial in the Oklahoma suit on Monday, April 29th, and that he, Mr. Mueller, was not fully prepared for trial; that he, Mr. Mueller, did

not have any or many physical exhibits to explain to the Court at such trial; and Mr. Mueller inquired whether deponent was in possession of any physical exhibits that deponent might lend to Mr. Mueller.

“(b) Deponent replied that several years ago, the model maker for Radio Condenser Company had prepared a model of the Marschalk patent and another model showing how the lever device of the Schaefer patent could be substituted for the lever device of the Marschalk patent, to demonstrate that there was no invention in so doing, and that deponent was and had been in possession of these two models for these many years, and that deponent would be glad to lend these models to Mr. Mueller for whatever use they might serve him, to be returned to deponent as soon as possible.

“(c) Pursuant to this discussion, these two models were delivered and loaned to Mr. Mueller.”

According to these admissions of Mr. James, Mr. Mueller “was not fully prepared for trial” and he “did not have any or many physical exhibits to explain to the Court at such trial”, so he called upon Mr. James for help. Mr. Mueller did not need models of the *accused* tuners, for they were commercial models in the possession of his own client. When he referred to “physical exhibits to explain to the Court” he obviously meant physical exhibits to demonstrate the contention that the patent is invalid. As this court well knows, physical exhibits of this kind require a great deal of advance legal work; in fact, the defense that is to be made must be fully decided upon before the exhibits can be prepared, because the purpose of the exhibits is to make the defense clear to the court.

In the *Associated Wholesale Electric* case, involving the patent here in suit, the Ninth Circuit Court of Appeals struck out the portion of the District Court’s opinion which said the patent was invalid for want of invention, so it would have been hazardous for Mr. James to have

depended upon the same defense that was reflected in the stricken portions of the District Court's opinion on that issue. Accordingly, a new defense was decided upon—the defense that the structure of the patent in suit could have been arrived at by taking the mechanism of the Marschalk patent No. 2,072,897 and substituting the lever device of the Schaefer patent No. 1,906,106 for the lever device of the Marschalk patent. Unless one were to rely solely upon the drawings in these patents themselves, the establishment of this defense required four physical exhibits: (1) a model of the Schaefer tuner, (2) “a model of the Marschalk patent and (3) another model showing how the lever device of the Schaefer patent could be substituted for the lever device of the Marschalk patent, to demonstrate that there was no invention in so doing” (quoted from the James affidavit), and (4) a chart showing enlarged figures from the Marschalk, Schaefer and Leishman patents to verify that these models were authentic.

The Schaefer tuner had been on the market, so a *commercial* model could be used for that; but the Marschalk device had never been on the market, and a special Marschalk model therefore had to be constructed, together with another model “showing how the lever device of the Schaefer patent could be substituted for the lever device of the Marschalk patent.”

It is not necessary for the Honorable Judges of this court to be familiar with the Schaefer and Marschalk patents. The important thing is that they were two prior art patents, which we can here just as well think of as patents A and B, and that the defense was to the effect that one could arrive at the structure of Leishman's re-issue patent here in suit by combining parts shown in patent A with parts shown in patent B. After this defense was decided upon, two special models had to be built. The device of patent A had been on the market, so a commercial model could be used for that; but since patent B had never been commercialized, a special model had to be made. And then another model had to be constructed

to show how it was alleged that parts of A could be combined with parts of B in order to simulate Leishman's structure.

Mr. Mueller's telephone call for help found Mr. James well prepared, and the latter's affidavit tells us the two specially constructed models were made by the model maker for Radio Condenser Company and that [R. Vol. I, p. 68] "deponent was and had been in possession of these two models for these many years." Mr. James' affidavit tells us that the "model of the Marschalk patent and another model showing how the lever device of the Schaefer patent could be substituted for the lever device of the Marschalk patent, to demonstrate that there was no invention in so doing" [James' affidavit, R. Vol. I, p. 68] were furnished to Mr. Mueller, pursuant to his telephone conversation [James affidavit, p. 68].

Inasmuch as Mr. James himself refers to one of his models as a "model showing how the lever device of the Schaefer patent could be substituted for the lever device of the Marschalk patent, to demonstrate that there was no invention in so doing", it is clear that the demonstration and use of this model at the trial would *in and of itself* constitute a presentation of the defense for which the model was constructed. To determine whether appellees controlled the defense in the Oklahoma case to the extent that the defense prepared by them was presented at the trial, we thus need only to learn whether these models were used. The certified copy of a portion of the transcript of the said trial [R. Vol. I, pp. 103 to 133], discloses that the defense presented against patent No. 20,827 consisted *entirely* of a demonstration and explanation of the two specially constructed models furnished by the plaintiffs, supported by a chart of enlarged figures from the Schaefer, Marschalk and Leishman patents to which these models pertained.

An examination of the record of the Oklahoma case reveals that the models furnished by appellees were the only specially constructed models introduced by the defense in

that action. As before mentioned, Mr. Foorman L. Mueller was counsel for The Richards and Conover Company, the Oklahoma defendant. In the portion of his opening statement contained in Volume I of the present record, pages 103 to 110 inclusive, Mr. Mueller introduced his various models and other pertinent physical exhibits. The following list shows the models that were introduced with respect to the reissue patent No. Re. 20,827, together with the pages in Volume I of the present record where they are first mentioned:

Defendant's Exhibit G, Radio Condenser Company tuner Model 28, one of the accused devices, page 104;

Defendant's Exhibit H, General Instrument Corporation tuner, another accused device, page 105;

Defendant's Exhibit I, the Crosley tuner involved in the former *Associated Wholesale Electric* case in California, page 105;

Defendant's Exhibit J, a drawing of the Crosley tuner, page 105;

Defendant's Exhibit K, a commercial model of the Zenith tuner, corresponding to the Schaefer patent No. 1,906,106, page 106;

Defendant's Exhibit L. This was the specially constructed model for the Marschalk tuner which Mr. James tells us in his affidavit was made by the Radio Condenser Company and furnished by him. Introduced on page 106;

Defendant's Exhibit M. This model, first mentioned on page 107, was the other model furnished by the present plaintiffs, as Mr. Mueller later tells us.

In introducing Exhibit L on page 106, Mr. Mueller says that it corresponds to Fig. 14 of the Marschalk patent. He further says, "Figure 14 of the Marschal (*sic*) patent shows the lever being operated by an electric solenoid. *We* have no facilities for it, that is, that electric solenoid, so *we*

have merely put a finger button on, and it can be operated by the hand in exactly the fashion that lever can." The word "we", which has been italicized for the purpose of this brief, here includes the Radio Condenser Company, because it was this company, according to Mr. James' affidavit, that built this model. It is significant that Mr. Mueller, in this use of the pronoun "we", thus makes no distinction between appellees here and the defendant in the Oklahoma suit.

As shown by the foregoing list, all of the models introduced by Mr. Mueller, with the exception of Exhibits L and M, were *commercial* models; and L and M were the specially constructed models built for defense purposes and furnished by the present plaintiffs at their expense.

When introducing Exhibit M, Mr. Mueller immediately sets it off from the others and explains its purpose. Beginning at the bottom of page 107, Mr. Mueller says: "For the purpose of this suit *and an explanation as illustrative of the defendant's position on invalidity*, we have a model, Defendant's Exhibit M, which combines, as we will later show, a lever out of the Marschalk patent, a lever out of the Schaefer patent, 1906106, and a rocker or rotary treadle out of the Marschalk patent, 20772897 (*sic*)."¹ In other words, it contained a part of prior art patent A and another part out of prior art patent B.

The affidavit of Mr. James, counsel for both appellees in patent causes, told us what defense argument this model was built to illustrate, and that defense, furnished by appellees, was adopted as the Oklahoma defendant's position on invalidity, for this statement of Mr. Mueller tells us in plain English that he was going to use this model "for the purpose of this suit and an explanation of the defendant's position on invalidity." Mr. Mueller's statement further shows that he knew exactly what prior art devices were supposed to be combined in his Exhibit M. He thus had the benefit of all the legal work that had to precede the conception and construction of this model; the model itself provided him with the means to demonstrate

the ready-made defense; and Mr. Mueller tells us that he intends to use it for that purpose. Except for the formality of asking the questions, Mr. Mueller's work was already done for him.

Now let us see just how this model *was* used and let us learn what defense Mr. Mueller actually presented against patent No. Re. 20,827, the patent in suit in both these actions.

Mr. Mueller's sole witness against this patent was his able expert, Dr. M. F. Spotts, associate professor of machine design at Northwestern University. Inasmuch as the Oklahoma defendant's case would naturally be made in the direct examination, a certified copy of Dr. Spotts' entire direct examination is included in the present Defendant's Exhibit 17. This testimony extends from page 111 to page 133, twenty-two pages in all.

An analysis of these pages shows that Dr. Spotts' direct examination was devoted entirely to a presentation of the defense provided by the appellees here. The first three pages are used to qualify the witness, and Mr. Mueller then asks Dr. Spotts if he is familiar with the Leishman patent No. Re. 20,827 and with the Marschalk and Schaefer patent (representative parts of which were alleged to be combined in Exhibit M, furnished by Mr. James).

The next question, on page 114, is about Exhibit L, the specially built model of the Marschalk device, also supplied by Mr. James, as shown by previous portions of this brief and the James affidavit.

Dr. Spotts is then asked about Defendant's Exhibit K. This was a commercial model of the Schaefer patent, showing one of the parts alleged to be combined in Mr. James' Exhibit M, which was "to demonstrate the defendant's position on invalidity."

Dr. Spotts is next requested to refer to Exhibit Y, a chart showing enlarged figures from the Leishman, Schaefer and Marschalk patents. After discussing this chart in relation to the Schaefer patent and examining Plain-

tiff's Exhibit 30, a model constructed by Leishman according to his patent, Dr. Spotts is asked (bottom of p. 117) to refer to the same chart, Defendant's Exhibit Y, to compare the Leishman rocker and Marschalk rocker, which Dr. Spotts later claimed was substantially reproduced in Exhibit M.

After five pages thus devoted to laying a foundation for the introduction of Defendant's Exhibit M, furnished by appellees, Mr. Mueller on page 118 gets down to Exhibit M, itself. This model is the subject of Dr. Spotts' entire examination for the next thirteen pages—until we get to the bottom of page 131. In the remaining two pages of his direct examination Dr. Spotts confirms the importance of the coaxial relationship which Leishman's claims call for, and he admits that the plunger of the accused device is an obvious substitute for the lever shown in the patent, for he says "a draftsman would make that substitution in the usual line of his work", and "a draftsman does those things every day in the week." At the bottom of page 133—only two pages after the discussion of Exhibit M is ended—Mr. Mueller tells Mr. Flam that he may cross-examine.

Of the eighteen pages of Dr. Spotts' testimony that dealt with defense arguments, five were thus used to explain the chart of enlarged drawings from the Schaefer, Marschalk and Leishman patents, and to show the commercial Schaefer tuner and the specially built Marschalk tuner supplied by Mr. James. The latter specially built model, like the drawings from the Schaefer, Marschalk and Leishman patent, were all necessary in order to lay a foundation for the introduction of Exhibit M, the combination model furnished by Mr. James "to demonstrate the defendant's position on invalidity," as Mr. Mueller put it. The remaining thirteen pages of the above-mentioned eighteen, were all devoted to the latter model.

Regarding this model M, around which the defense was thus built, Mr. Mueller said (see page 122): "I will be

glad to tell where I got it. I borrowed it from counsel for the General Instrument Corporation because they had made up models and I was not able to engage the time of a mechanic to make them myself. These things, the same as papers, are handed back and forth between counsel." A few lines earlier at the top of the same page, Mr. Mueller had said: "If I had been doing it I would have had other models, Your Honor."

But Mr. Mueller was not doing it. The record, the statements of Mr. Mueller and the affidavit of Mr. James all show it was the plaintiffs in the present action who were doing it.

Corpus Juris on Patents, Vol. 48, pp. 406, 407, section 644 (2) in footnote 38(a), states the law with respect to such a situation as follows:

"* * * A person is bound by the decision in a patent infringement suit where, although not a party to the suit, he openly, avowedly, and with the knowledge of plaintiff, assumed, controlled, and conducted, *or participated in*, the defense at his own cost and for his own interest." (Emphasis supplied.)

The courts have recently recognized that no premium should be placed upon a person's ability to keep his participation a secret, and have logically ruled that it makes no difference whether the plaintiff at the time of the trial knew about the participation or not.

"International states the question involved in this appeal thus: May a judgment be *res judicata* as to a person not a party who defended the suit on behalf of the record defendant where such participation was not open and avowed to the knowledge of the plaintiff during the pendency of the suit? This issue, if decided in the affirmative, disposes of International's appeal in this action. Since this court concludes that the answer to the question thus posed is in the af-

firmative, it is unnecessary to go into the question whether the evidence is sufficient to establish that the defendant openly and avowedly defended the suit. . . .” *Caterpillar Tractor Co. v. International Harvester Co.*, 120 F. (2d) 82, at 84 (C. C. A. 3).

The Ninth Circuit Court of Appeals has very clearly stated the circumstances under which a participant is bound. As far as his activities in connection with the suit are concerned, it is not required that he conduct the defense or control the entire defense: it is only necessary that he *aid* in the defense. But there is one other thing apart from his activities that is required. The participant is not bound if he is a stranger to the action: he must *have the right to participate and control the defense*. If he has this relationship to the controversy, then any aid that he may render is sufficient to bind him by the judgment.

In *Hy-Lo Unit & Metal Products Co. v. Remote Control Mfg. Co., Inc.*, 83 F. (2d) 345, at 350, the Ninth Circuit Court of Appeals held that the defendant was not bound by participation in a previous action because it did not make the valves involved in the said previous action. The defendant was thus a stranger to that action and did not have the right to participate and control the defense. To make its decision clear, the Ninth Circuit Court of Appeals very lucidly stated the circumstances under which a participant is bound. Said the court:

“These decisions by the Supreme Court establish the proposition that, in order for a person not formally made a party to a suit to be estopped by the decision therein, he must either be in privity with a party thereto in the strict sense of the term or he must not only *aid* in the prosecution or defense of a suit, *but have the right to participate and control such prosecution or defense.*” (Emphasis added.)

Unlike the participant who this court held was not bound in the *Hy-Lo* case, appellees assert right in the complaint that they manufactured the tuners accused in the Oklahoma action. Therefore no one has denied that appellees had the right to participate and control the defense in that case. They could have assumed the entire defense. Consequently, if they aided in the defense, they are bound by the judgment.

This brief has shown that the appellees did far more than *aid* in the defense in Oklahoma. They were the ones who decided upon the defense that was used. They conceived and built the special equipment that was needed to present and demonstrate that defense to the court. The attorney in patent causes for both of the appellees has admitted in his own affidavit that he supplied this equipment to the defense counsel in the Oklahoma case at the latter's request. The Oklahoma defense counsel has admitted in the record of that case that he received these specially constructed models and that one of them, Exhibit M, was going to be used "to demonstrate the defendant's position on invalidity." The Oklahoma defendant thus accepted the defense that was prepared by the appellees in the present action, and the record shows that this became the *entire* defense, that out of 18 pages of direct defense testimony, 13 pages were devoted to explaining and operating the model that was supplied by appellees to demonstrate the defense, and the other 5 pages were devoted to laying the foundation for its introduction.

Appellees are thus manifestly bound by the Oklahoma decision.

If a person not a party to a suit has the right to participate and control the defense, he may safely take part in the adjustment of damages *after a pro confesso decree has been entered*, but the Supreme Court has permitted no greater participation and has freed only those who have refused to assume *any* control over it.

In *I. T. S. Rubber Company v. Essex Rubber Company*, 272 U. S. 429, at 433, 71 L. Ed. 335, at 338, the Supreme Court said:

“On the appeal the circuit court of appeals stated that the record showed clearly that the Essex Company *refused* to become a party to the suit or assume *any* control over it, and *took no part* in the conduct *or control* of the suit, ‘but only in the adjustment of the damages’ after the *pro confesso* decree had been entered; . . .” (Emphasis added.)

Appellees did not refuse to assume any control over the defense in the Oklahoma case. On the contrary, it was they who decided upon the defense that the patented Leishman structure could be arrived at by combining the teachings of the Schaefer and Marschalk patents. Since no Marschalk tuner was available, they built a model of it in their own plant and therefore at their own expense. They also prepared “another model showing how the lever device of the Schaefer patent could be substituted for the lever device of the Marschalk patent, to demonstrate that there was no invention in so doing.” (James’ affidavit.) When Mr. Mueller phoned Mr. James, patent counsel for appellees, that he, Mr. Mueller, was not prepared for trial, Mr. James supplied the necessary preparation. It was Mr. James’ models that disclosed and demonstrated the defense that was used at the trial, Mr. Mueller merely presented the defense which appellees prepared and which they had implemented with the necessary accoutrements.

Under the law, appellees are bound by the Oklahoma decision, and this court should therefore instruct the lower court to enter the proposed supplemental pleadings and render judgment in appellant’s favor.

**Appellees' Course Requires That the Claims at Issue
Be Held Valid as Applied to Them.**

The complaint states [R. Vol. I, p. 4] that this action arises out of a suit brought by appellant against The Richards and Conover Company in the U. S. District Court for the Western District of Oklahoma, Civil Action No. 2155, alleging infringement of claims 7 to 11 of the reissue patent No. Re. 20,827 through the sale of radio sets embodying the tuners manufactured by the plaintiffs herein. Appellees could of course have intervened at the outset in that suit, and it has already been shown that they did subsequently aid and participated in the defense of that action. The Oklahoma district is fifteen hundred miles closer to the New Jersey residences of both appellees than is the Southern District of California. But the present plaintiffs did not want the case to be tried in Oklahoma: they wanted it tried here in the Ninth Circuit where they expected to benefit from this court's opinion in the *Associated* case, *supra*, through the doctrine of *stare decisis*. In order to change the forum to one of their own choosing, appellees filed the instant Declaratory Judgment suit praying that appellant be enjoined from further asserting "that said Letters Patent No. Re. 20,827, or any claim thereof, has been infringed . . . by radio condensers and tuners which were manufactured and sold by the plaintiffs, or either of them, or installed in radio receiving sets by any of their customers." [R. Vol. I, p. 11.]

Appellees' reliance upon the *Associated* decision in the instant suit is shown from the fact that they set it forth right in the complaint [R. Vol. I, p. 7]. The same paragraph in the complaint also mentioned the lower court's decision in the same case, which said that the claims at issue were invalid for want of invention; but the complaint neglected to mention that the lower court's holding of invalidity was stricken out by this court's opinion on

appeal. Affirming the lower court's judgment on grounds having nothing to do with validity, the appellate court said:

"The judgment declares that the claims 'are invalid for want of invention.' In the view we take, the declaration is unnecessary. As to its correctness or incorrectness, we express no opinion. The judgment is modified by striking therefrom the above quoted declaration and, as thus modified, is affirmed." (137 F. 2d at p. 728.)

The presumption of validity was thus restored to the patent.

Inasmuch as this court set aside the lower court's finding that the patent was invalid for want of invention, it is obvious that the arguments upholding the trial court's opinion were not sufficient to convince this court that the lower court was right, for Rule 52(a) of the Federal Rules of Civil Procedure requires that the findings of a trial court shall not be set aside unless they are clearly in error. Those attacking the validity of the patent in that case were not able to carry the heavy burden of proof that falls upon those challenging the validity of a patent. If mere doubts were raised, it was not necessary for this court to express an opinion, for the well-established rule requires that all doubts must be resolved in favor of the patent. This court did that very thing when it set aside the findings of the lower court by striking out the finding that the claims were invalid for want of invention. This action of the appellate court was thus the same as reversing the lower court on the issue of validity. Claims 7 to 11 are valid in this circuit.

In coming to this circuit in order to benefit from the *Associated* decision through the doctrine of *stare decisis*, and in using this decision as a basis for their Motion for Summary Judgment, appellees have taken a definite posi-

tion and chosen their course of action. They should not now be permitted to take another position inconsistent with the one they have chosen. In this circuit to which they have come, and because of the decision which they urge the courts to apply, the claims are valid. The situation here is analogous to a quasi-equitable estoppel. Appellees should not be heard to challenge the effect of the very decision which they came here to invoke. This court should hold that claims 7 to 11 are valid in so far as these appellees are concerned.

If this Honorable Court should fail to hold that appellees are bound by the Oklahoma decision because of their participation in the defense of that action, then it should hold that claims 7 to 11 of the reissue patent are valid in so far as they apply to these appellees, and that, by virtue of the evidence hereinbefore discussed, the tuners manufactured by appellees are infringements of these claims.

Even though the motion for summary judgment was made by appellees, this court nevertheless has the right to render a decision in favor of appellant.

“If either the proponent of a claim or the defending party moves for a summary judgment, and the court finds that the moving party is not entitled thereto, but that the other party is so entitled, it would seem that the court has the power to enter the proper judgment, although a cross-motion therefor was not made.” 3 *Moore's Federal Practice*, Sec. 56.02, page 3183.

That procedure was followed in *Northland Greyhound Lines, Inc. v. Amalgamated Association of Street, Electric Railway and Motor Coach Employees of America*, 9 Fed. Rules Service 56c.54, Case 1, in which the court made the foregoing quotation from Moore. Judgment was also rendered in favor of the adversary of the moving party in *Hooker v. New York Life Ins. Co.*, 9 Fed. Rules

Service 56c.54, Case 2. In that case, the court quoted Moore as follows:

“Rule 54 (c) gives the court the power to enter the final judgment to which the prevailing party is entitled, even if the party has not demanded such relief in his pleadings, except in default judgment cases. The theory is that the form of the pleadings should not place a limitation upon the power of the court to do justice. So where one party has invoked the power of the court to render a summary judgment against his adversary, it is reasonable that this invocation gives the court power to render a summary judgment for his adversary if it is clear that the case warrants that result. Note 8, 3 *Moore, Federal Practice*, Section 56.02.

If the Issue of Validity Is to Be Tried Appellees Should Be Required to Answer Defendant's Interrogatories 4, 5, 6, 7, 9, 10, 11, 17 and 18.

Specification of error 7 reads:

“The District Court erred in sustaining appellees' objections to appellants' interrogatories 4, 5, 6, 7, 9, 10, 11, 17 and 18, requiring data on the volume of appellees' sales to show the extent of the commercial success of appellees' devices.”

The interrogatories to which appellees objected may be found in the record in Vol. I, pp. 21, 22 and 23. These were objected to “on the grounds that the information called for is irrelevant to any issue in this case.” [R. Vol. I, p. 25.] The court sustained appellees' objections [R. Vol. I, p. 26].

The law is well settled that such information is not irrelevant. Commercial success is often the deciding factor on the issue of validity.

In *Dillon Pulley Co. v. McEachran et al.*, 69 F. (2d) 144, at 146, the court said:

“* * * a presumption of validity may arise equally from the commercial success of an infringer as from the commercial success of the patentee or his assigns.”

In *Eibel Process Company v. Minnesota & Ontario Paper Company*, 261 U. S. 45, at 56, 67 L. Ed. 523, at 529, the Supreme Court likewise attaches the same significance to the success of an infringer as to that of a shareholder or licensee. Said the court:

“* * * It can hardly be that dividends on the shares of stock in the Eibel Company, held by the five large companies, would furnish motive enough for them to continue to be licensees, and to use something that was not of great advantage to them in their chief business of making of paper; and certainly no such motive would explain the action of the licensees who are not stockholders, *or that of the infringers*, in continuing to use the Eibel pitch.” (Emphasis supplied.)

Regarding the significance of commercial success in the case of *Research Products Co., Limited, et al. v. Tretolite Co. et al.*, 106 F. (2d) 530, at 532, the Ninth Circuit Court of Appeals said:

“* * * The use of this type of chemical was highly successful and it is estimated that this acid

process had resulted in the recovery of over a billion barrels of crude oil, at a relatively small cost.

“So great and immediate a success speaks strongly of invention, adding emphasis to the strong presumption of invention, raised by the issuance of the patent.”

In its most recent case upholding the validity of a patent, the Supreme Court said:

“* * * Once the method was discovered it commended itself to the public as evidenced by marked commercial success. These factors were entitled to weight in determining whether the improvement amounted to invention and should, in a close case, tip the scales in favor of patentability. Accepting, as we do, the findings below, we hold the patent valid and infringed.” *Goodyear Tire & Rubber Co., Inc., et al. v. Ray-O-Vac Co.*, 321 U. S. 275 at 279, 64 S. Ct. 593 at 595.

Appellees were thus wrong in stating that the information requested in appellant's interrogatories was “irrelevant to any issue in this case,” and the court should not have sustained the objection.

If the issue of validity is to be tried, it is highly important that appellant have the information asked for in these interrogatories, and the lower court should be instructed to require appellees to supply the information requested.

**Summary Judgment Should Not Have Been Entered
in the Instant Case, Especially When It Was in
Direct Conflict With a Decision of Another Fed-
eral Court Rendered After a Full Trial.**

The judgment of the lower court in the instant case is the first summary judgment ever granted in a patent case in direct conflict with the opinion of another U. S. District Court, as far as appellant has been able to learn after an exhaustive search. Such a summary judgment was requested in another case, but there the U. S. District Court for the Northern District of Ohio said:

“Furthermore, although this court cannot in the circumstances say that the issue is *res judicata*, the fact that the patent was approved by a court of competent jurisdiction after full trial (Cold Metal Process Co. v. United Engineering & Foundry Co., D. C., 3 F. Supp. 120) would make it almost presumptuous for this court to declare the patent invalid upon nothing more than a comparison of documents which had been before the other court. * * * Motion overruled.” *E. W. Bliss Co. v. Cold Metal Process Co.*, 47 Fed. Supp. 897 at p. 899.

The basic requirements for a summary judgment are such that it seems unthinkable for a court even to consider the granting of a summary judgment in direct conflict with the decision of another court that was rendered after a full trial. It is well established that a summary judgment should only be granted when all the facts clearly indicate that the opposing party could not possibly prevail if a trial were held. A practical demonstration that such opposing party not only *could*, but actually *did*, prevail after a full trial, should consequently definitely preclude the granting of summary judgment.

In the Second Circuit case of *Doehler Metal Furniture Co., Inc., v. United States*, 149 F. (2d) 130, in which Judge Learned Hand, Judge Frank and Judge Chase heard the appeal, Judge Frank, in rendering the opinion, said (p. 135):

“We take this occasion to suggest that trial judges should exercise great care in granting motions for summary judgment. A litigant has a right to a trial where there is the slightest doubt as to the facts.”

In the instant case, two genuine issues of fact were presented. In defendant's answer [R. Vol. I, p. 15] defendant denied paragraph 8 of the complaint [R. Vol. I, p. 7] which alleged that plaintiffs' tuners did not infringe the claims at issue. This presented a first genuine issue of fact.

A second genuine issue of fact was presented in the affidavit of LeRoy J. Leishman [R. Vol. I, p. 46], filed in opposition to plaintiffs' Motion for Summary Judgment, and accompanied by ten prior art patents and sixteen other exhibits which showed that plungers and levers had long been known as equivalents in this art. Deponent there said that “none of the said exhibits and none of the ten patents presented in support of Defendant's Memorandum Opposing Plaintiffs' Motion for Summary Judgment, were presented in evidence in the case of Leishman vs. Associated Wholesale Electric Company, mentioned in the said memorandum.”

That averment should have made it necessary to follow the new evidence instead of this court's former decision with respect to the equivalency of levers and plungers for operating appellant's combination. That evidence, if genuine, proved beyond any possible doubt that plungers were well known as proper substitutes for levers in this art when appellant's patent was granted. Inasmuch as the

Supreme Court's criteria for mechanical equivalents were thus fully met, the case for infringement was now complete. If there could have been any possible doubt about any of this, then a very genuine issue of fact was presented.

If no doubt existed about the genuineness of the new evidence or about appellant's averment that it was not before this appellate court when it rendered its decision in the *Associated* case, then a decision could only be rendered in appellant's favor and appellees' motion for summary judgment of non-infringement could not be entertained.

If a genuine issue was present, a trial should have been held. In order for appellees to establish the proposition that there was no genuine issue and that the facts were all in their favor, it would have been necessary for appellees to prove (1) that appellant's new evidence was not genuine, or (2) that this evidence was before this Circuit Court of Appeals when it rendered the decision in the *Associated* case. Appellees *could not* and *did not* do either of these things, finding 18 [R. Vol. I, p. 91] to the contrary notwithstanding.

Regarding the moving party's burden of proof, the Eighth Circuit Court of Appeals said:

"On a motion for a summary judgment the burden of establishing the nonexistence of any genuine issue of fact is upon the moving party, all doubts are resolved against him, and his supporting affidavits and depositions, if any, are carefully scrutinized by the court." *Walling v. Fairmont Creamery Co.*, 139 F. (2d) 318 at 322.

To the same effect is the decision of the United States Circuit Court of Appeals for the District of Columbia in the case of *Wittlin v. Giacalone, et al.*, 154 F. (2d) 20 at 21, 22:

“We are impelled to that conclusion because it is well established that one who moves for summary judgment has the burden of demonstrating clearly the absence of any genuine issue of fact, and that any doubt as to the existence of such an issue is resolved against the movant. The courts are quite critical of the papers presented by the moving party, but not of the opposing papers.”

When the moving party has not carried its burden of demonstrating clearly the absence of any genuine issue of fact, the opposing party should never be cut off without a trial.

“Illustrative of the dangers, in this respect, of summary judgment, if not cautiously employed, is a recent case in the court below. There the judge refused to grant summary judgment for defendants, despite a mass of impressive affidavits, containing copies of corporate records, the accuracy of which plaintiffs did not deny in their affidavits, and which on their face made plaintiffs’ case seem nothing but a sham; at the trial, however, cross-examination of the defendants revealed facts, theretofore unknown by plaintiffs, that so riddled the defendants’ case as it had previously appeared on the summary judgment motion that the judge entered judgment against them for several million dollars, from which they did not appeal.”

Arnstein v. Porter (C. C. A. 2), 154 F. (2d) 464 at 471.

In the instant case, between the filing of the motion for summary judgment and the granting of the motion, a practical demonstration was given as to what could happen at a trial involving the very same tuners with which we are concerned in the present action. In addition to other evidence, the following testimony was given by Dr. M. F. Spotts, associate professor of machine design at Northwestern University [R. Vol. I, p. 112], who was the expert witness for the defendant against Leishman in the Oklahoma case of *Leishman v. The Richards and Conover Company* [Defendant's Exhibit 17, R. Vol. I, pp. 131 and 132]:

“A. (By Dr. Spotts) If one wished to use a plunger that would give straight line motion as support for the tappet rather than the pivoted lever which gives motion in the arc of a circle of a rather large radius, draftsmen would have no compunctions about substituting a plunger giving a straight line for the lever, giving an arc of a circle, since the motion is rather small while the tappet is being brought into contact with the rocker. A draftsman would make that substitution in the usual line of his work.

“Q. (By the Court): Easy to do? A. Oh, yes.

Q. It would impose no serious problem where a lever is used and you decided you wanted to use a plunger, to change the design to make it work with a plunger? A. A draftsman does those things every day in the week in his usual line of work.”

Inasmuch as this testimony was actually given *for the other* side at the Oklahoma trial by the associate professor of machine design at Northwestern University, how could the lower court here have felt sure that an equally candid witness for the other side might not make the same admissions if a trial were held in the instant case? *Of course* it could not have been sure. Then it was manifestly highly improper for the court to grant appellees' motion for summary judgment in their favor.

In the recent case of *Associated Press et al. v. United States*, 326 U. S. 1, 6, 65 S. Ct. 1416, 1418, the Supreme Court said:

"We agree that Rule 56 should be cautiously invoked to the end that parties may *always* be afforded a trial *where there is a bona fide dispute of facts between them.*" (Emphasis added.)

In *Sartor et al. v. Arkansas Natural Gas Corporation*, 321 U. S. 620, 627, 64 S. Ct. 724, 728, the Supreme Court said:

"The Court of Appeals below heretofore has correctly noted that Rule 56 authorizes summary judgment only where the moving party is entitled to judgment as a matter of law, where it is quite clear what the truth is, that no genuine issue remains for trial, and that the purpose of the rule is not to cut litigants off from their right of trial by jury if they really have issues to try."

If the new evidence presented by the defendant leaves any vestige of a doubt regarding the equivalency of levers and plungers, clearly there should be a trial.

Conclusion.

This brief has shown by evidence of a nature that cannot be contradicted that plungers were well known in this art as proper substitutes for levers in the operation of tuners and other shaft-positioning devices, and that they were even known as equivalents for levers for the purpose of moving tappets in such mechanism. On the matter of the equivalency of appellees' rockers and tappets to the corresponding elements in the patented structure, this record is the same as that in the *Associated Wholesale Electric* case, and this Honorable Court's holding with respect to these two elements is therefore applicable here. It is thus established that all three elements of appellees' tuners are the equivalents of the corresponding elements shown in the patent. This court should therefore reverse the lower court and rule in harmony with the U. S. District Court for the Western District of Oklahoma to the effect that the tuners here involved are infringements of claims 7 to 11 of reissue patent No. Re. 20,827.

It has also been shown that appellees participated in the defense of the suit brought by appellant against The Richards and Conover Co. in the U. S. District Court for the Western District of Oklahoma, and that appellees are therefore bound by the judgment of that court. This Honorable Court should accordingly instruct the lower court to enter appellant's proposed supplemental answer and render judgment in favor of appellant on the ground that the appellees are bound by the said Oklahoma decision because of their participation in the defense of that suit. This Honorable Court, in so holding, should nevertheless rule upon the matter of the equivalency of the aforementioned plungers and levers as shown by the new evidence,

because such a ruling is important in view of other litigation now before the lower court.

This brief has also shown that appellees, in insisting upon a decision in this forum instead of in the Oklahoma forum which the appellant provided for them, cited the case of *Leishman v. Associated Wholesale Electric Co.*, *supra*, right in the complaint and were thus well aware that this decision restored the presumption of validity to the patent. In coming to this circuit to benefit by that opinion, appellees should be required to accept the situation as they find it, and they should therefore not be heard to challenge the validity of the patent. Inasmuch as appellees urge that this decision be applied, they are thereby precluded from raising the issue of validity. The reissue patent here in suit is consequently valid as far as the appellees are concerned.

Should this Honorable Court fail for any reason to instruct the lower court to hold that appellees are bound by the Oklahoma decision, it should rule, for the reasons stated, that the patent is valid as applied to them; and it should also rule, in accordance with the new evidence, that appellees' tuners are infringements of claims 7 to 11 of the reissue patent.

Should this court for any reason fail to agree that appellees are bound by the Oklahoma decision or that the patent is valid as applied to them, then this court should remand the case to the lower court for a trial upon these matters. In order that these defenses might be made and additional evidence adduced, the lower court should be instructed to enter appellant's supplemental answer to the effect that appellees are bound by the Oklahoma decision, and it should also be instructed to require them to an-

swer Defendant's Interrogatories 4, 5, 6, 7, 9, 10, 11, 17 and 18. If the case is so remanded, this court should nevertheless rule that the claims at issue, if valid, are infringed, so that the lower court may have the benefit of such ruling and not have to try the issue of infringement all over again.

Should this court feel that the mass of evidence already presented is not sufficient to establish the equivalency of plungers and levers for operating appellant's combination, then this Honorable Court should wipe out the summary judgment and give appellant the additional opportunity that a regular trial affords for bringing out further evidence.

In all events, the summary judgment in appellees' favor should be set aside. It was highly improper to have based such a decision upon the doctrine of *stare decisis* when the new evidence created a record vastly different from that in the *Associated* case. The Oklahoma transcript showed what can happen at a trial, and the court below should never have rendered a summary judgment in direct conflict with the judgment of another court regarding the same devices and the same claims.

Respectfully submitted,

LEROY J. LEISHMAN,

Appellant, in propria persona.

